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IN THE

Supreme Court of the United States

OCTOBER TERM, 1987

KYOCERA INTERNATIONAL, INC.
and KYOTO CERAMIC CO., LTD.,

Petitioners,

vs.

KENNECOTT CORPORATION,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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QUESTION PRESENTED

Where it is admittedly impossible to discern the invention from a reading of a patent, did the Court of Appeals err in interpreting Section 112 of the Patent Act by sanctioning resort to matters beyond the patent specification (such as the making of products and study thereof under a microscope) to fulfill the statute's written description requirement that "The [patent] specification shall contain a written description of the invention"?

LIST OF PARTIES

The parties to the proceedings below are the petitioners (defendants-appellees below) Kyocera, International, Inc. and Kyoto Ceramic Co., Ltd., and the respondent (plaintiff-appellant below) Kennecott Corporation.[1]

In accordance with Rule 28.1 of the Rules of the Supreme Court, the parent companies, subsidiaries (other than wholly owned subsidiaries) and affiliates of the petitioners are set forth in Appendix A at A1.

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[1] It is noted that after commencement of the litigation below, petitioner Kyoto Ceramic Co., Ltd. changed its name to Kyocera Corporation.

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In The
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KYOCERA INTERNATIONAL, INC.,
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Petitioners,

v.

KENNECOTT CORPORATION,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Petitioners, Kyocera International, Inc. and Kyoto Ceramic Co., Ltd., respectfully pray that a Writ of Certiorari issue to review the judgment in favor of respondent, Kennecott Corporation, entered on December 22, 1987, by the United States Court of Appeals for the Federal Circuit in its cause numbered 87-1151.

OPINIONS BELOW

The opinion of the Court of Appeals for the Federal Circuit is reported at 835 F.2d 1419 (Fed. Cir. 1987) and reprinted as Appendix B at B1-B11; and the judgment of the Federal Circuit is reprinted as Appendix C at C1. The opinion of the United States District Court for the Southern District of California is reported at 2 U.S.P.Q.2d 1455 (S.D. Cal. 1986) and reprinted as Appendix D at D1-D12; and the judgment entered by the District Court is reprinted as Appendix E at E1-E3.

JURISDICTION

The judgment of the Court of Appeals for the Federal Circuit was entered on December 22, 1987, and this Petition for a Writ of Certiorari was filed within ninety (90) days thereafter. The jurisdiction of this Court is invoked under 28 U.S.C. §1254(1).[2]

STATUTES INVOLVED

The statute principally involved is Section 112 of the current Patent Act, 35 U.S.C. Sections 1 *et seq.*("Patent Act"), which reads in pertinent part as follows:

> The specification shall contain a written description of the invention, and of the manner and process of making it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most closely connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention . . . .[3]

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[2] A timely suggestion for rehearing in banc was denied by the Court of Appeals for the Federal Circuit in an order entered February 5, 1988, and reprinted as Appendix F at F1-F2.

[3] Hereinafter, all references to a "Section" refer to a section of the Patent Act unless expressly indicated otherwise. Section 112 is made applicable to this case through Section 120 which reads in pertinent part:

> An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, . . . which is filed by an inventor or inventors named in the previously filed application shall have the

STATEMENT OF THE CASE

A. Summary Of The Proceedings And Decisions Below

This patent infringement action was commenced in 1980 by respondent Kennecott Corporation ("Kennecott") against petitioners Kyocera International, Inc. and Kyoto Ceramic Co., Ltd. (collectively, "Kyocera") for the infringement of two Kennecott patents. Only one of these patents, U.S. Patent No. 4,179,299 ("the '299 patent"), was the subject of the decisions below and is thus directly at issue in this Petition. Federal subject matter jurisdiction was invoked under 28 U.S.C. §1338(a).

Section 102(b) of the Patent Act bars the grant of a patent on an invention which was sold in the United States more than one year before the application for patent. *See UMC Electronics Co. v. United States*, 816 F.2d 647, 649 n.1 (Fed. Cir. 1987), *cert. denied*, ___ U.S. ___, 108 S.Ct. 748, 98 L.Ed.2d 761 (1988). Kennecott conceded that more than one year before the application for the '299 patent was filed, it sold in

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same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

The full text of Sections 112 and 120, and all other sections of the Patent Act cited in this Petition, are reprinted as Appendix G at G1-G9.

the United States products covered by the '299 patent. Therefore, the '299 patent is invalid *unless* some exception to the one-year rule applies. The controversy below revolved around a narrow exception to this rule found in Section 120.

Under Section 120, the application for the '299 patent will be deemed filed on the date Kennecott filed an earlier patent application, U.S. Pat. No. 4,312,954 ("the '954 patent" or "the earlier patent"), *if and only if the earlier patent application disclosed the invention of the '299 patent "in the manner provided by the first paragraph of section 112."*[4] Since the application for the '954 patent was filed before Kennecott's product sales, if the '299 patent is given the filing date of the earlier application, the '299 patent would not be barred under Section 102(b). Thus, the *sole* issue below was whether, as required by Section 120, the earlier application for the '954 patent disclosed the invention of the '299 patent "in the manner provided by the first paragraph of section 112" which provides in pertinent part:

> The specification [of the patent] shall contain a written description of the invention . . . .[5]

The material facts necessary to resolve this matter were admittedly not in dispute and, therefore, the issue

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[4] The '954 patent is the second patent joined in the action below. There are other prerequisites under Section 120 which are not pertinent here.

[5] Under Section 111, an application for patent must include (1) a specification as prescribed by Section 112; (2) a drawing as prescribed by Section 113; and (3) an oath as prescribed by Section 115.

was solely one of law ripe for summary disposition.[6] Such summary disposition turned exclusively on the statutory construction of Section 112. The District Court construed the statute one way and granted Kyocera's motion for summary judgment of patent invalidity. The Court of Appeals for the Federal Circuit ("Federal Circuit") construed the statute another way and reversed the summary judgment grant. This Petition seeks review of the decision of the Federal Circuit in order to properly construe this very important statutory section.

B. Additional Facts Pertinent To The Decisions Below And To This Petition

The '299 patent claims the invention to be a product (called "a sintered ceramic body") having a certain microstructure (called "a predominantly equiaxed microstructure"). More specifically, claim 1 of the patent, which defines the invention of the '299 patent,[7] provides in pertinent part:

> A sintered ceramic body . . . having a predominantly equiaxed microstructure.[8]

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[6] For purposes of the summary judgment motion below, Kyocera admitted all material facts alleged by Kennecott. *See* Appendix D at D2 and D3, Findings 8, 9, 11 and 12.

[7] It is the claims of the patent which define "the subject matter which the applicant regards as his invention" (Second paragraph of Section 112) and which "measure the invention." *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369, 82 L.Ed. 1402, 1405 (1937); *SRI Intern. v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1121 (Fed. Cir. 1985).

[8] Claim 1 provides in full:

1. A sintered ceramic body consisting essentially of:
(a) from about 91 to about 99.85% by weight silicon

The earlier '954 patent application, however, concededly does not explicitly mention, refer to, define, or describe, within its four corners an "equiaxed microstructure." *See* Appendix D at D2, Finding 7; Appendix B at B4, second pertinent fact. And, although the earlier patent application does describe a process for forming a sintered ceramic body, there is admittedly no way to tell from that application whether the product so formed will have an equiaxed microstructure or whether the inventors knew that such product might have an equiaxed microstructure. *See* Appendix D at D3 Finding 10; Appendix B at B4. Only if a person proceeded to actually form a product according to the process of the '954 patent application and later examined the product under a microscope, would or could that person determine that the product had an equiaxed microstructure. *See* Appendix B at B11.[9]

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carbide, wherein at least 95% by weight of the silicon carbide is of the alpha phase;
(b) up to about 5.0% by weight carbonized organic material;
(c) from about 0.15 to about 3.0% by weight boron; and
(d) up to about 1.0% by weight additional carbon;
and having a predominantly equiaxed microstructure. *See* Appendix B at B4.

[9] Even then, the product might or might not have an equiaxed microstructure. It was conceded, however, for purposes of the motion for summary judgment, that the product would have an equiaxed microstructure if the person followed the process of the '954 patent application using certain parameters (e.g., temperature), including those identified as being "preferred" and those of the thirty (30) examples in the application. *See, e.g.*, Appendix B at B4, fourth pertinent fact.

In short, there is no way to tell from the '954 patent application alone whether the product formed by the process discussed therein had an equiaxed microstructure or whether the inventors knew that such product might have an equiaxed microstructure.

C. Section 112 As Interpreted Differently By The Courts Below

Section 112 requires that:

> The [patent] specification shall contain a written description of the invention . . . .

The District Court construed the statute as demanding that the invention be determinable from the description ("four corners") of the patent specification (application):

> It must be apparent to one skilled in the art, from the four corners of the application itself, that the claimed product will inherently result from the adequately described process. *See* Appendix D at D9, Conclusion 10.

Since the invention of the '299 patent, a ceramic body having an equiaxed microstructure, could not be discerned from the '954 patent application, the District Court found Section 112's mandate unsatisfied. Thus, the District Court granted Kyocera's motion for summary judgment of patent invalidity.

The Federal Circuit, however, construed the statute, contrary to its literal language, as allowing resort to matters completely outside the '954 patent application to discern the invention and to fulfill Section 112's description requirement; in this case forming products and studying their microstructure under a microscope:

> It was conceded that anyone with a microscope would see the microstructure of the product of the '954 application. The disclosure in a subsequent application of an inherent property of a product does not deprive that product of the benefit of an earlier filing date. Nor does the inclusion of a description of that property in later-filed claims change this reasonable result. *See* Appendix B at B11.

Since the invention of the '299 patent, a ceramic body having an equiaxed microstructure, could be discerned if one formed products by following the examples in the '954 patent application and then examined such samples under a microscope, the Federal Circuit found the requirements of Section 112 satisfied. Thus, the Federal Circuit reversed the grant of summary judgment.

D. This Petition Asks This Court To Construe Section 112 Of The 1952 Patent Act, A Statutory Section Which Has Not Been Construed By This Court Since The Passage Of The 1952 Patent Act

This Petition seeks issuance of a Writ of Certiorari to review the decision of the Federal Circuit in order to construe Section 112. The issue to be resolved is *purely* one of statutory construction. It would require the Court to determine whether Section 112's mandate that "the specification shall contain a written description of the invention," can be satisfied when it is admittedly impossible to discern the invention from the "four corners" of the specification.

REASONS FOR GRANTING THE WRIT

A. Section 112's Disclosure Requirement, Which Comes Into Play In A Great Number Of Contexts, Is Of Critical Importance To The Patent System; It Is The Quid Pro Quo For The Patent Monopoly Defined By Congress To Implement The Constitutionally Mandated Goal Of The Patent Laws, To Promote The Progress Of Science And The Useful Arts

The Constitution grants Congress broad power to legislate to "promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. Constitution, Art. I, §8, cl. 8. The patent laws promote this progress by offering inventors exclusive rights for a limited period as an incentive for their inventiveness and research efforts. *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 480, 40 L.Ed.2d 315, 325 (1974); *Diamond v. Chakrabarty*, 447 U.S. 303, 307, 65 L.Ed.2d 144, 148 (1980). In return for the right of exclusion, the patent laws impose upon the inventor a requirement of disclosure. Only if the requirement of disclosure is fully met, is the Federal Government willing to pay the high price of 17 years of exclusive use. *Kewanee, supra*, 416 U.S. at 480-481, 40 L.Ed.2d at 325.

The requirements for disclosure are set out in Section 112. *Kewanee, supra*, 416 U.S. at 480-481, 40 L.Ed.2d at 325; *Chakrabarty, supra*, 447 U.S. at 312, 65 L.Ed.2d at 152. These requirements are intended to ensure that the three following "great ends" are accomplished: (1) that the government may know what

it has granted and what will become public property when the patent expires; (2) that licensed persons may know, during the term of the patent, how to make and use the invention; and (3) that other inventors may know what part of the field of invention is occupied (and thus stimulate further research and development). *Gill v. Wells*, 89 U.S. 1, 24-25, 22 L.Ed. 699, 710 (1874).

In furtherance of these ends, Section 112 includes a requirement that the patent application contain, *inter alia*, a full and clear description of the invention. *Kewanee, supra*, 416 U.S. at 480-481, 40 .Ed.2d at 325. This requirement, called the "written description" (or simply "description") requirement, was included in the very first patent statute of 1790, and carried over in all subsequent patent statutes, including the current Patent Act. *See In re Barker*, 559 F.2d 588, 591-593 (CCPA 1977), *cert. denied*, 434 U.S. 1064, 55 L.Ed.2d 588 (historical review of the description requirement);[10] *Chakrabarty, supra*, 447 U.S. at 312, 65 L.Ed.2d at 152 (referring to the "written description"

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[10] Section 2 of the Patent Act of 1790, ch. 7, 1 Stat. 109, 110 (requiring patent applicant to "deliver . . . a specification in writing, containing a description . . . of the thing or things . . . invented or discovered . . ."); Section 3 of the Patent Act of 1793, ch. 11, 1 Stat. 318, 321 (requiring applicant to "deliver a written description of his invention"); Section 6 of the Patent Act of 1836, ch. 357, 5 Stat. 117, 119 (requiring applicant to "deliver a written description of his invention or discovery"); Section 26 of the Patent Act of 1870, ch. 230, 16 Stat. 198, 201 (codified in 1874 as Revised Statutes §4888, 35 U.S.C. §33) (requiring that the applicant "shall file in the patent office a written description of the [invention]").

requirement of Section 112).[11] The description requirement ensures the additional salutary goal of guaranteeing that at the time the patent application is originally filed, the applicant has possession of subject matter which he later claims as *his* invention. *See In re Edwards*, 568 F.2d 1349, 1351-1352 (CCPA 1978); *In re Smith*, 481 F.2d 910, 914 (CCPA 1973). Only then is it in the public interest that the applicant's exclusive rights to the invention vis-a-vis the public (including later inventors) be fixed as of the date of filing.

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[11] This should not be confused with two separate and additional requirements of disclosure in Section 112. Specifically, Section 112 also includes an "enablement" requirement, *i.e.*, that the disclosure also describe "the manner and process of making it [the invention], in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most closely connected, to make and use the same." And, Section 112, further includes a "best mode" requirement, *i.e.*, that the disclosure "set forth the best mode contemplated by the inventor of carrying out his invention." These are three separate and distinct requirements, each one of which has to be met to satisfy Section 112. *See* Ernest Bainbridge Lipscomb III, *Lipscomb's WALKER ON PATENTS*, Vol. 3, §10.1 at p. 183-184 (3rd ed. 1985); Donald S. Chisum, *Patents*, Vol. 2, §7.01 at p. 7-2 (1987); William C. Robinson, LL.D., *The Law Of Patents For Useful Inventions*, Vol. II, Ch. 1, Section V, §484, at p. 73 (1890) (discussing predecessor to Section 112). Complete knowledge of all three of these points is necessary to render the invention available to the public without further experiment or exercise of inventive skill. William C. Robinson, LL.D., *The Law Of Patents For Useful Inventions*, Vol. II, Ch. 1, Section V, §484, at p. 73 (1890) (discussing predecessor to Section 112). Thus, a patent which fails to adequately describe the invention (description requirement) is invalid even if it adequately teaches how to make and use the invention (enablement requirement). *See, e.g., Barker, supra*, 559 F.2d at 591; Donald S. Chisum, *Patents*, Vol. 2, §7.04 at p. 7-52 (1987).

Section 112's description requirement is especially critical where, as here, if the description requirement is not strictly enforced, a patent, otherwise invaiid under Section 102(b), will be allowed to stand. Thus, failure to enforce the description requirement will also frustrate the objectives of Section 102(b), namely encouraging an inventor to *promptly* file a *complete* application to ensure early and widespread public disclosure of inventions. *UMC, supra,* 816 F.2d at 652 (quoting *General Electric Co. v. United States,* 654 F.2d 55, 61-64 (Ct. Cl. 1981) (in banc) (discussing four basic policies behind Section 102(b)).[12]

The importance of Section 112's description requirement is heightened by the fact that it comes into play in a great number of contexts, particularly, *whenever* an applicant adds a claim after the application is originally filed and the claim may at least arguably contain previously unclaimed features. For example, it

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[12] For example, in *Muncie Gear Works v. Outboard Marine & Co.,* 315 U.S. 759, 86 L.Ed. 1171 (1942), several years after the patentee filed his application on an improved boat propeller, he added claims not supported by the disclosure in the original application. 315 U.S. at 768, 86 L.Ed. at 1178. During the intervening period and more than two years before the claims were added, products were sold covered by the added claims. *Id.* This Court invalidated the patent claims under the predecessor statute to Section 102(b), Revised Statutes §4886 (35 U.S.C. §31 (1939)), stating:

> To sustain the claims in question upon the established and admitted facts would require a plain disregard of the public interest sought to be safeguarded by the patent statutes, and so frequently present but so seldom adequately represented in patent litigation.
>
> We therefore hold that the claims in question are invalid under §4886 of the Revised Statutes . . . . *Id.*

applies where, as here, the applicant argues that his application is entitled to the benefit of the filing date of an earlier *U.S.* patent application under Section 120. *See, e.g., In re Smith*, 458 F.2d 1389, 1396 (CCPA 1972). It also applies where the applicant argues that his application is entitled to the benefit of the filing date of an earlier *foreign* application under Section 119. *See, e.g., In re Wertheim*, 541 F.2d 257, 261-262 (CCPA 1976). It likewise applies where the applicant adds patent claims identical to those in the application of another to provoke an "interference" proceeding in the Patent Office to determine who first invented the claimed invention. *See, e.g., Fields v. Conover*, 443 F.2d 1386, 1391 (CCPA 1971). It further applies when an applicant during the prosecution of his application simply adds patent claims. *See, e.g., In re Ruschig*, 379 F.2d 990, 995-996 (CCPA 1967). Still further, it applies where the owner of an issued patent seeks to have the patent "reissued" under Section 251 with added or amended claims. *See, e.g., In re Salem*, 553 F.2d 676, 682 (CCPA 1977).

In sum, Section 112's description and other disclosure requirements, which come into play in a great number of circumstances, are of critical importance to the entire patent system. These requirements are the means chosen by Congress to implement the constitutionally mandated goal of the patent laws, to promote the progress of science and useful arts. When these requirements are not met, the public is denied the *quid pro quo* of the patent grant; the *sine qua non* of a valid patent being a complete disclosure to the public in strict compliance with Section 112. *See White Consol. Industries v. Vega Servo-Control*, 713 F.2d 788, 791 (Fed. Cir. 1983).

B. The Federal Circuit's Interpretation Of Section 112's Description Requirement Is Contrary To The Plain Meaning Of The Statute

In cases of statutory construction, the starting point is the langauge of the statute. *Chakrabarty, supra,* 447 U.S. at 308, 65 L.Ed.2d at 149; *Diamond v. Diehr,* 450 U.S. 175, 182, 67 L.Ed.2d 155, 162-163 (1981). Just as limitations should not be read into the Patent Act where none otherwise exist (*id.*), so too the express statutory prerequisites to obtaining a patent should be strictly observed. *Sears, Roebuck & Co. v. Stiffel Co.,* 376 U.S. 225, 230, 11 L.Ed.2d 661, 666 (1964). That is, patents must comply completely and precisely with the requirements established by Congress. *General Electric Co. v. Wabash Appliance Corp., supra,* 304 U.S. at 369, 82 L.Ed. at 1405. Moreover, the plain meaning of the statute is controlling unless a different legislative intent is apparent from the purpose and history of the statute. *Jefferson Cty. Pharm. Assn. v. Abbott Labs.,* 460 U.S. 150, 157, 74 L.Ed.2d 882, 890 (1983).

In the case of Section 112, the meaning of the statute is plain. The patent specification must *itself* contain a written description of the invention. In that regard Section 112 explicitly and unequivocally provides in pertinent part:

> "The *specification* shall contain *a written description of the invention. . . .*" (emphasis added).

There is absolutely nothing in the Legislative History of which petitioners are aware which indicates any contrary Congressional intent. Quite the opposite is true. A purpose of the Section 112 description requirement is to guarantee that at the time the patent

application is originally filed, the applicant has possession of the subject matter he later claims as *his* invention. This can, of course, be best achieved only by following the letter of the statute which mandates that such possession of the invention be disclosed by the patent application itself. Permitting resort to extrinsic materials to identify the invention, certainly cannot possibly further this important statutory objective.[13] The same is true as to the objective of Section 102(b), which is to encourage an inventor to *promptly* file a *complete* application to thereby promote early and widespread public disclosure of inventions. This objective would be seriously undermined if, as here, a patent otherwise invalid under Section 102(b) because it was applied for more than a year after the sale of products embodying the invention, is able to escape invalidity by being afforded the filing date of an earlier application (several years earlier) which did not even identify or allude to the invention.

In sum, the plain meaning of the language of Section 112 can be respected, and the objectives of that and other patent statutes furthered, only by requiring that

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[13] It is true that the invention need not be described *in ipsis verbis* to satisfy the description requirement of Section 112. *Edwards, supra*, 568 F.2d at 1351-1352. But, *the specification* still must necessarily and reasonably convey to one of ordinary skill in the art that the inventor possessed, at the time the application was originally filed, the subject matter he later claims as his invention. *Edwards, supra*, 568 F.2d at 1352; *Langer v. Kaufman*, 465 F.2d 915, 918 (CCPA 1972); *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983). The "necessary and only reasonable construction" given the specification langauge is said to be the "legal equivalent" of the claim language. *Wagoner v. Barger*, 463 F.2d 1377, 1380 (CCPA 1958).

the patent specification alone, on its face and within its four corners, describe the claimed invention.

C. The Federal Circuit's Interpretation Of Section 112's Description Requirement Is In Conflict With This Court's Decisions Applying Section 112's Predecessor Statute

The decision of the Federal Circuit here appears wholly inconsistent with the principles announced by this Court in cases applying Revised Statutes §4888 (35 U.S.C. §33 (1930)), the predecessor statute to Section 112 which also required that the patent application include "a written description of the [invention]."

For example, in *Permutit Co. v. Graver Corp.*, 284 U.S. 52, 76 L.Ed. 163 (1931), the Court invalidated a patent on an improved water softening filter because the patent specification was incomplete and the claims were indefinite. The filter included a bed of water softening crystals called "zeolites" in between a top and bottom screen. 284 U.S. at 55, 76 L.Ed. at 165. In the patented filter a space was left between the zeolites and the top screen (called "free zeolite bed"), while in previous filters the top screen rested directly on the zeolites (called "locked zeolite bed"). 284 U.S. at 55-57, 76 L.Ed. at 165. However, neither the specification nor the claims mentioned the space feature, although the patent drawings did indicate such feature. 284 U.S. at 57-58, 76 L.Ed. at 166. In holding the claims invalid for inadequate disclosure, the Court repeatedly emphasized the lack of any description of the space feature "in the specification":

> [The patent] is invalid for lack of the disclosure prescribed by Rev. Stat. §4888,

> U.S.C. title 35, §33. There is no mention *in the specification* of either a "free" or a "locked" zeolite bed . . . . Nor does Claim 1 or Claim 5 make mention of a "free" zeolite bed. . . . As the patentee has thus failed to give *in the specification* "a written description" and has likewise failed particularly to point out and distinctly claim the free zeolite bed, as "the part, improvement, or combination which he claims as his invention or discovery," the patent is void. 284 U.S. at 57-58, 76 L.Ed. at 166 (emphasis added).
>
> . . .
>
> Moreover, while the drawings may be referred to for illustration and may be used as an aid in interpreting the specification or claim, they are of no avail where there is an entire absence of description of the alleged invention or a failure to claim it. . . . The free bed was neither described *in the specification* nor claimed in either Claim 1 or Claim 5. 284 U.S. at 60, 76 L.Ed. at 167 (emphasis added).

The same is true here. There is no description of an equiaxed microstructure in the '954 patent application. The equiaxed microstructure is neither described in the specification nor claimed in the claims (nor shown in any drawing). No one can discern that a product formed as set out in the application has an equiaxed microstructure. Neither can one discern that the inventors knew that an equiaxed microstructure would be so formed. The disclosure is therefore woefully inadequate. Resort to the drawings to overcome the deficiency was impermissible in *Permutit*, just as resort

to formation and examination of products is improper here, because, in the words of this Court:

> there is an entire absence of description of the alleged invention or a failure to claim it. *Id.*

The decision of the Federal Circuit below also appears inconsistent with the decision of this Court in *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U.S. 47, 83 L.Ed. 34 (1938). In *Schriber-Schroth*, the Court invalidated two patents on an improved piston for gas engines for the reason that the patent specification was incomplete. The piston included two "webs" (or walls) for connecting two parts of the piston. 305 U.S. at 51, 83 L.Ed. at 36. The patentee amended the specification and the claims to state that the webs were "laterally flexible" (rather than "extremely rigid" as stated in the patent application as filed). 305 U.S. at 54-56, 83 L.Ed. at 38. The Court concluded that "laterally flexible" webs were not disclosed in the application as originally filed and therefore the specification failed to satisfy the disclosure requirements of Revised Statutes §4888, 35 U.S.C. §33 (1930). 305 U.S. at 57, 83 L.Ed. at 39. The Court explicitly rejected the argument that the original disclosure was adequate because flexibility of the webs was an "inherent property" of the metal out of which the webs are made so that one skilled in the art would know that the webs were "laterally flexible":

> Even if those skilled in the art would have known that a piston with webs which would yield enough laterally to accommodate the constriction of the split skirt under the pressure developed by thermal expansion would work most effectively if the webs were laterally flexible rather than rigid, *that was not the invention which Gulick described* by his

> reference to an extremely rigid web. 305 U.S. at 58-59, 83 L.Ed. at 40 (emphasis added).

The same is true in this case. "A sintered ceramic body . . . having a predominantly equiaxed microstructure" is *not* the invention described by Kennecott in the much earlier '954 patent application which failed to refer to such microstructure either expressly or by implication.

The decision of the Federal Circuit below also appears inconsistent with the decision of this Court in *General Electric Co. v. Wabash Appliance Corp., supra,* 304 U.S. 364, 82 L.Ed. 1402. In *Wabash,* this Court invalidated patent claims on a tungsten filament for incandescent lamps because the claims were indefinite. The patentee argued that the subject product claims were proper when interpreted as being limited to a tungsten filament formed by the process described in the specification. 304 U.S. at 373, 82 L.Ed. at 1407. After assuming (*arguendo*) that the product claims could be further refined by reference to the process in the specification, the Court nonetheless rejected the argument because:

> the description of the Pacz process is likewise silent as to the nature of the filament product. 304 U.S. at 373, 82 L.Ed. at 1407-1408.

The same is true here. The description of the Kennecott process in the '954 patent application, like the description of the Kennecott product, is painfully silent as to the nature of the microstructure of the ceramic body. There is thus no support in the '954 patent application for a "sintered ceramic body . . . having an equiaxed microstucture."

D. The Federal Circuit's Interpretation Of Section 112's Description Requirement In This Case Is In Conflict With Precedent In The Federal Circuit

The Federal Circuit, which has exclusive jurisdiction of *all* patent appeals, is bound by the decisions of the Court of Customs and Patent Appeals ("CCPA"), a predecessor court to the Federal Circuit. *South Corp. v. United States*, 690 F.2d 1368, 1369-1371 (Fed. Cir. 1982). However, the CCPA case of *Langer, supra*, 465 F.2d 915, and this case are apparently irreconcilable.

In *Langer*, the issue was whether the '488 patent application satisfied Section 112's description requirement as to a claim which recited a product having a gamma form x-ray diffraction pattern (as opposed to alpha or delta form). The specification described the product in an example labeled "Run E," but was silent as to the product's diffraction pattern. The applicant argued that the diffraction pattern "is the inherent pattern of the product described in Run E." 465 F.2d at 918. The CCPA rejected that argument because:

> *The '488 specification* disclosure does not necessarily lead to the conclusion that the Run E product was the gamma form. It could have been one of the other purple forms. . . . [S]ince no other information as to the pattern of the Run E product is given *in the '488 specification*, there is nothing to inevitably tie the Run E product to the gamma form. . . . 465 F.2d at 918-919 (emphasis added).

The same is true here. The '954 patent application does not mention, refer to, define, or describe the term "equiaxed microstructure." From a reading of the

specification, it is impossible to discern whether the product has an equiaxed microstructure or some other microstructure.

E. Review And Reversal By This Court Will End Litigation Over The '299 Patent

Reversal by this Court would terminate litigation over the '299 patent in the action below and in potential disputes with other parties. If the Court construes Section 112 as requiring that the invention be described within the four corners of the patent specification, as the literal words of the statute require, the patent is invalid and the District Court judgment finding the patent invalid will be reinstated in this case and will also bar any further litigation over the patent.

F. Summary Of Reasons For Granting The Writ

Section 112's description and other disclosure requirement issues arise in a great number of contexts. Compliance with such disclosure requirements represents Congress' judgment as to the best means for ensuring the progress of science and the useful arts through the patent laws as expressed in the Constitution. The decision of the Federal Circuit, liberally construing the statute as allowing resort to matters outside the patent specification to identify and describe the invention, is contrary to the plain meaning of the statute. The statute unequivocally states that "[t]he specification shall contain a written description of the invention." The decision is also inconsistent with the spirit of this Court's decisions applying Section 112's predecessor statute and with precedent of the Federal Circuit as well. Finally, review and reversal by this

Court will terminate litigation over the '299 patent in the action below and in potential disputes with other parties.

CONCLUSION

For the reasons stated above, this Court should grant the Petition for Certiorari to review the judgment of the Federal Circuit.

Respectfully submitted,

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APPENDIX A

APPENDIX A

List of Parent Companies, Subsidiaries (other than wholly owned) and Affiliates of Kyocera Corporation (formerly Kyoto Ceramic Co., Ltd.)

Ivy International Co., Ltd.
Videotex Center Ltd.
Kyocera Finance Co., Ltd.
Japan New Media System Co., Ltd.
Kagoshima Oxiton Co., Ltd.
Miyaki Electric Machines Co., Ltd.
Daini-Denden Inc.
Taito Co., Ltd.
Feldmühle Kyocera Europa GmbH
Kyocera Electronics Europe GmbH

List of Parent Companies, Subsidiaries (other than wholly owned) and Affiliates of Kyocera International, Inc.[1]

Kyocera Feldmuehle Inc.
Kyocera Unison Inc.

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[1] Kyocera International, Inc. is a wholly owned subsidiary of Kyocera Corporation.

APPENDIX B

APPENDIX B

KENNECOTT CORP.
v.
KYOCERA INTERN., INC.
Cite as 835 F.2d 1419
(Fed. Cir. 1987)

KENNECOTT CORPORATION,

Plaintiff-Appellant,

vs.

KYOCERA INTERNATIONAL, INC.
and Kyoto Ceramic Co., Ltd.,

Defendant-Appellee.
No. 87-1151.

United States Court of Appeals,
Federal Circuit.

Dec. 22, 1987.

Clyde F. Willian, Willian Brinks Olds Hofer Gilson & Lione, Ltd., Chicago, Ill., argued, for plaintiff-appellant. With him on the brief, were Jack C. Berenzweig and Raymond W. Green.

Paul L. Gardner, Spensley, Horn, Jubas & Lubitz, Los Angeles, Cal., argued, for defendant-appellee. With him on the brief, were Stuart Lubitz, Saul Epstein and David Henty.

Before MARKEY, Chief Judge, DAVIS and NEWMAN, Circuit Judges.

PAULINE NEWMAN, Circuit Judge.

Kennecott Corporation appeals the final judgment of the United States District Court for the Southern District of California,[1] in which the district court granted summary judgment to the defendants Kyocera International and Kyoto Ceramic Co., Ltd. (together "Kyocera"), holding that United States Patent No. 4,179,299 ("the '299 patent") is invalid in terms of the "on sale" bar of 35 U.S.C. §102(b). Kennecott's claim of patent infringement was dismissed. We reverse.

The Controlling Question

The judgment of invalidity turned on the sole question of whether the claims of the '299 patent are entitled, as a matter of law, to the benefit of the filing date of its parent patent application which eventually issued as U.S. Patent No. 4,312,954 ("the '954 application"), filed on June 5, 1975. If so entitled, the sales events in 1977 can not effect an invalidity bar. If not so entitled, Kennecott admits that its sales activities occurred more than one year before May 1, 1978, the filing date of the continuation-in-part application that issued as the '299 patent.

Background

On summary judgment all facts material to the result must be either undisputed or, if disputed, must be resolved in favor of the party opposing summary judgment. *Litton Industrial Products, Inc. v. Solid State Systems Corp.*, 755 F.2d 158, 163, 225 USPQ 34, 37

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[1] *Kennecott Corporation v. Kyocera International, Inc. and Kyoto Ceramic Co., Ltd.*, 80-0516 R(M) (S.D.C. Dec. 17, 1986).

(Fed.Cir. 1985). Rule 56, Fed.R.Civ.Proc. The question of the sufficiency of the disclosure of the '954 application to support the '299 claims is a matter of law based on underlying facts. All facts material to the issue are here deemed undisputed, based on admissions by Kyocera for the purpose of its motion for summary judgment.

Kyocera states in its brief on appeal that it did not concede or admit all the facts that Kennecott says it did. The district court found, however, that:

> Finding 11. For the purposes of this Motion only, the material facts set forth in all of the affidavits and in all of the exhibits submitted by plaintiff in opposition to Defendants' Motion, are undisputed by defendants.

Kyocera has not assigned error to this finding, and it is bound thereby.

The continuation-in-part '299 application contains a substantial part of the disclosure of the '954 parent application, plus a description of and photomicrographs showing the equiaxed microstructure.[2] It is not disputed that the photomicrographs were of the product made and described in the '954 application, and produced in the original examples.

The '299 patent claims contain the words "equiaxed microstructure" that were not present in the '954 specification and claims. This is the only difference at issue. '299 patent claim 1 is representative:

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[2] "Equiaxed microstructure" is the crystal structure of the silicon carbide in submicron size grains that are not highly elongated and that do not have exaggerated grain growth. As defined in the '299 patent the ratio of the maximum dimension of the grains to the minimum dimension is less than 3:1.

1. A sintered ceramic body consisting essentially of:
   (a) from about 91 to about 99.85% by weight silicon carbide, wherein at least 95% by weight of the silicon carbide is of the alpha phase;
   (b) up to about 5.0% by weight carbonized organic material;
   (c) from about 0.15 to about 3.0% by weight boron; and
   (d) up to about 1.0% by weight additional carbon; and having a predominantly equiaxed microstructure.

Pertinent undisputed or conceded facts include the following:

the high (over 95%) alpha silicon carbide ceramic body that is described in the '954 application has an equiaxed microstructure;

the '954 application does not mention the equiaxed microstructure of the high-alpha silicon carbide ceramic body, nor state the requirements for forming such microstructure;

the inventors knew that the high-alpha silicon carbide ceramic body had an equiaxed microstructure, and it was known that ceramics from high-alpha silicon carbide could have this structure;

examples 1-30 in the '954 application, all the examples using high-alpha silicon carbide, all produce a ceramic body having an equiaxed microstructure;

the method set forth in the '954 application using the high-alpha silicon carbide invariably produces a ceramic product having an equiaxed microstructure.

Kennecott asserts that the equiaxed microstructure is inherent in the structure produced in the '954

application, and that the '299 claims, which specifically name the equiaxed structure, therefore enjoy the benefit of the earlier filing date. Kennecott also asserts, and Kyocera denies, that Kyocera conceded the question of inherency in the course of conceding all disputed facts on its motion for summary judgment.

It is apparent that Kyocera conceded the factual premises[3] of inherency by conceding that examples 1-30 produced, without undue experimentation, a product having an equiaxed microstructure. What is disputed is the legal implication of this inherent production of an equiaxed product.

The district court concluded that for the '954 specification to meet the written description requirement, one reading the specification must know from the "four corners" of the document, without recourse to information outside the specification, that the ceramic product has an equiaxed microstructure. The district court held that the specification of the '954 application met the enablement requirement of section 112 but not the written description requirement, and thus that it was immaterial that the product disclosed in the '954 application was the same as that claimed in the '299 patent.

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[3] Kyocera raises on this appeal factual issues that appear to contradict its concessions before the district court, including issues related to Kennecott's representations to the patent examiner in prosecuting the '299 application. However, it is too late in the proceeding for Kyocera to retreat from its blanket concession of the factual issues.

Discussion

For the '299 claims to receive the benefit of the '954 application's filing date, 35 U.S.C. §120 requires, *inter alia*, that the invention of the claims be disclosed in the '954 specification in the manner required by 35 U.S.C. §112, first paragraph, which provides:

> §112 ¶1: The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The purpose of section 112, first paragraph, is to ensure that there is an adequate disclosure of the invention for which patent rights are sought. The purpose of the description requirement of this paragraph is to state what is needed to fulfill the enablement criteria. These requirements may be viewed separately, but they are intertwined.

[1] The incorporation of the requirements of section 112 into section 120 ensures that the inventor had possession of the later-claimed invention on the filing date of the earlier application. *In re Edwards*, 568 F.2d 1349, 1351, 196 USPQ 465, 467 (CPPA 1978). The written description must communicate that which is needed to enable the skilled artisan to make and use the claimed invention. A description that does not meet this requirement is legally insufficient. *In re Wilder*, 736 F.2d 1516, 1520, 222 USPQ 369, 372

(Fed.Cir.1984), *cert. denied*, 469 U.S. 1209, 105 S.Ct. 1173, 84 L.Ed.2d 323 (1985).

It was undisputed that the only written description in the '299 application that was not present in the original '954 disclosure was the description and pictures of the product's microstructure. Kennecott points to authority that the added description of a property of a previously disclosed product does not deprive claims to that product of the benefit of a prior disclosure of the product. Kyocera responds that because the '954 specification is silent as to the microstructure of the product, and because one would not know whether the product had an equiaxed microstructure merely by reading the specification, the specification is inadequate in law to support claims that require an equiaxed microstructure. Kyocera also asserts that the equiaxed microstructure is not obtained without physical manipulation of the process of the '954 application, and that any concession it may have made as to production of an equiaxed product is limited to the specific conditions used in examples 1-30 of the '954 specification.

[2] Taking the last contention first, it was admitted that the products of examples 1-30 have the equiaxed microstructure, and that one skilled in this art could readily determine the microstructure of the product. Kyocera's arguments on appeal as to the need for manipulation of conditions are contravened in the affidavit evidence referred to in Finding of Fact 11, *supra*. We conclude that it was established before the district court that the high-alpha products of the '954 application have the equiaxed microstructure.

On the issue of sufficiency of the earlier disclosure, the body of precedent teaches that the legal conclusion

depends on the particular facts. In *In re Edwards* the court considered a chemical compound that was not described in the earlier application, and stated that the earlier and later applications need not use the identical words, if the earlier application shows the subject matter that is claimed in the later application, with adequate direction as to how to obtain it. The court observed that the chemical reactions described in the earlier filing "will inherently produce, as the predominant component, the [later claimed] compound." 568 F.2d at 1352, 196 USPQ at 467. The facts in *Edwards* are strongly analogous to those herein, for Kennecott's '954 examples 1-30 all produce a ceramic that has an equiaxed structure.

The facts before us are not like those discussed in *In re Ruschig*, 379 F.2d 990, 154 USPQ 118 (CCPA 1967), referred to by the district court, but are analogous to those discussed in *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971). In *Reynolds* the question was whether words describing a function that was inherent in the claimed product could be added to the specification by amendment, or whether such description was "new matter." The court cited with approval the holding in *Technicon Instruments Corp. v. Coleman Instruments, Inc.*, 255 F.Supp. 630, 640-41, 150 USPQ 227, 236 (N.D.Ill.1966), *aff'd*, 385 F.2d 391, 155 USPQ 369 (7th Cir.1967), that:

> By disclosing in a patent application a device that inherently performs a function, operates according to a theory, or has an advantage, a patent applicant necessarily discloses that function, theory, or advantage even though he says nothing concerning it.

Quoted at 443 F.2d at 389, 170 USPQ at 98. It was concluded that the express description of the inherent property, since not "new matter," could be added to the specification with effect as of the original filing date.

The Court of Customs and Patent Appeals has long recognized that an invention may be described in different ways and still be the same invention. In *In re Kirchner*, 305 F.2d 897, 904, 134 USPQ 324, 330 (CCPA 1962), the court held that compliance with section 120

> does not require that the invention be described in the same way, or comply with section 112 in the same way, in both applications.

Id. In *Kirchner* the court authorized the addition to the specification of descriptive matter concerning the use of the compounds without loss of the parent application's filing date. In the '299 patent, by contrast, the additional material was added not only to the specification, but to the claims. Thus Kyocera argues that it is immaterial that the product in the '299 claims is inherently the same as that produced in the '954 application, because unlike *Kirchner* the '299 claims include the new descriptive matter.

The Court of Customs and Patent Appeals did not adopt the position that is now urged by Kyocera. In *In re Nathan*, 328 F.2d 1005, 1008-09, 140 USPQ 601, 604 (CCPA 1964), the court held that the later-added limitation to the claims of the compound's alpha orientation was "an inherent characteristic" of the claimed subject matter, and reversed a new matter rejection. The *Nathan* court explained that "a subsequent clarification of or a change in an original

disclosure does not necessarily make that original disclosure fatally defective." *Id.* at 1008, 140 USPQ at 603.

Kennecott argues that Kyocera is pressing the position rejected in *Kirchner*, wherein the court cautioned that it is necessary to avoid confusing "the invention itself which is the subject matter claimed . . . with one of the factors which is taken into consideration in determining whether the invention is or is not patentable from the standpoint of meeting 35 U.S.C. 103." *Id.* 305 F.2d at 903-04, 134 USPQ at 329-30. The *Kirchner* court held that it was not required "that a parent case disclose the same utility as a later application to entitle the latter to the benefit of the filing date of the parent." *Id.* at 904, 134 USPQ at 330. In the case at bar the additional description was not of a new use, but of the existing physical structure of the product. On the basis of this precedent, the inclusion of the existing microstructure as a descriptive term in the '299 claims does not cause the '299 claims to lose their entitlement to the date of the first-filed '954 application.

The district court relied on *Langer v. Kaufman*, 465 F.2d 915, 918, 175 USPQ 172, 174 (CCPA 1972). In *Langer* the diffraction pattern specifically recited in an interference count was not expressly described in the specification. The court held, "To prove inherency, the burden is on appellants to show that the 'necessary and only reasonable construction to be given the disclosure by one skilled in the art is one which will lend clear support to . . . [this] positive limitation in the interference count.' " *Id.* (emphasis omitted) (quoting *Binstead v. Littmann*, 242 F.2d 766, 770, 113 USPQ 279, 282 (CCPA 1957)). The issue in *Langer* was

entitlement to the benefit of constructive reduction to practice, which the court denied despite evidence that one of the experiments, Run E, produced the claimed diffraction pattern. The court has generally applied this standard of the "necessary and only reasonable construction" as a basis for determining whether an application could, on the basis of an inherent property, support a limitation in an interference count. *See, e.g., Wagoner v. Barger*, 463 F.2d 1377, 1380, 175 USPQ 85, 86-87 (CCPA 1972); *Snitzer v. Etzel*, 531 F.2d 1062, 1076, 189 USPQ 415, 419 (CCPA 1976). This standard, arising in the interference context, is consistent with that of the other cases on the issue of compliance with section 112, first paragraph.

In this case, the invention of the '299 claims is a ceramic product. That product is the same as the product in the '954 application, and has the same structure. It was conceded that anyone with a microscope would see the microstructure of the product of the '954 application. The disclosure in a subsequent patent application of an inherent property of a product does not deprive that product of the benefit of an earlier filing date. Nor does the inclusion of a description of that property in later-filed claims change this reasonable result.

We conclude that the district court erred in holding that the '299 claims were not entitled to the '954 filing date.

REVERSED.

APPENDIX C

APPENDIX C

United States Court of Appeals for the Federal Circuit

No. 87-1151

KENNECOTT CORPORATION,

Plaintiff-Appellant,

vs.

KYOCERA INTERNATIONAL, INC. and
KYOTO CERAMIC CO., LTD.,

Defendant-Appellee.

Judgment

ON APPEAL from the U.S. District Court for the Southern District of California

in CASE NO(S). 80-0516-R(M)

This CAUSE having been heard and considered, it is

ORDERED AND ADJUDGED: REVERSED

ENTERED BY ORDER OF THE COURT

DATED DEC 22 1987 Francis X. Gindhart

Francis X. Gindhart, Clerk

ISSUED AS A MANDATE: February 16, 1988

COSTS: Against, Appellees

PRINTING $497.04

TOTAL $497.04

APPENDIX D

APPENDIX D

District Court, S.D. California

KENNECOTT CORPORATION,

vs.

KYOCERA INTERNATIONAL, INC.

No. 80-0516-B(M)
Decided December 15 and 16, 1986

Wright & L'Estrange, San Diego, Calif., and Clyde F. Willian and Jack C. Berenzweig, of Chicago, Ill., for plaintiff.

Paul L. Gardner, Saul Epstein, and Spensley, Horn, Jubas & Lubitz, all of Los Angeles, Calif., for defendants.

Rhoades, District Judge.

The following Findings of Facts and Conclusions of Law are hereby entered following this Court's review of the parties' briefs and oral arguments on defendants' Motion for an order holding that the effective filing date of the claims in plaintiff's United States Patent No. 4,179,299 is May 1, 1978, the date that the original application for that patent was filed, and not June 5, 1975, the date that plaintiff's application for Patent No. 4,312,954 was filed.

FINDINGS OF FACT

1. This is a patent infringement suit, wherein the plaintiff charges the defendants with infringement of

plaintiff's United States Patents Nos. 4,312,954 (the '954 patent) and 4,179,299 (the '299 patent).

2. Both the '954 patent and the '299 patent are directed to sintered silicon carbide ceramic bodies.

3. The application for the '954 patent was filed on June 5, 1975.

4. The original application for the '299 patent was filed on May 1, 1978; it was designated as a continuation-in-part of the application for the '954 patent.

5. The issue to which these Findings are addressed is whether the effective filing date of the '299 patent is the June 5, 1975, filing date of the application for the '954 patent or the May 1, 1978, filing date of the original application for the '299 patent.

6. The claims of the '299 patent all recite, *inter alia*, a sintered ceramic body having a predominantly "equiaxed microstructure." The application for the '299 patent defines, describes and contains photomicrographs of the equiaxed microstructure claimed. See, e.g., Figures 2-7 and column 2, lines 6-10 and 54-68; column 5, lines 1-3; column 6, lines 3-48; and column 11, lines 28-54.

7. The application for the '954 patent does not explicitly mention, refer to, define, or describe, within its four corners, an "equiaxed microstructure."

8. Plaintiff asserts and defendants admit (for purposes of this motion only) that each of examples 1-30 described in the '954 patent application will, when carried out, produce an equiaxed microstructure.

9. Plaintiff asserts that defendants admit (for purposes of this motion only) that the inventors of the '954 and '299 patents knew they had obtained an

equiaxed microstructure before the '954 patent application was filed.

10. Plaintiff's expert witness, Dr. Anthony Evans, who is considered by both parties to be an expert in the art to which the '954 and '299 patents pertain, testified as follows during his deposition:

> "Q: Is there any way you can tell from the '954 specification itself whether or not those samples 1 through 30 were equiaxed?
>
> A: No.
>
> Q: Is there any way of knowing from the patent application whether the inventors knew that the samples were equiaxed?
>
> A: Well, no mention is made of the microstructure in here, so I really have no way of reading or inferring what the inventors knew of the microstructure with regard to grain shapes."

11. For the purposes of this Motion only, the material facts set forth in all of the affidavits and in all of the exhibits submitted by plaintiff in opposition to Defendants' Motion, are undisputed by defendants.

12. For purposes of this Motion only, Defendants agree that the '299 patent meets all of the requirements of 35 U.S.C. §120, except that the '954 patent application does not meet the description requirement set forth in the first paragraph of 35 U.S.C. §112.

CONCLUSIONS OF LAW

1. 35 U.S.C. §112, first paragraph, requires that the specification of an application for a patent "shall contain a written description of the invention, and of

the manner and process of making it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same . . . ."

2. The first paragraph of 35 U.S.C. §112 includes two separate and distinct requirements, i.e., (1) that the *invention* be described, and (2) that it be described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use it. These two separate and distinct requirements have sometimes been referred to as (1) a description requirement and (2) an enablement requirement. A patent specification may meet the enablement requirement without meeting the description requirement, and thereby fail to comply with Section 112's mandate.

> "A specification may contain a disclosure that is sufficient to enable one skilled in the art to make and use the invention and yet fail to comply with the description of the invention requirement. *Fields v. Conover*, 443 F.2d 1386, 1391, 58 CCPA 1366, 1372, 170 USPQ 276, 280 (1971); *In re Ruschig*, 379 F.2d 990, 995-96, 54 CCPA 1551, 1558-59, 154 USPQ 118, 123 (1967)." *Application of Barker*, 559 F.2d 588 at 591 [194 USPQ at 472-473] (CCPA 1977).

3. "Compliance with the full disclosure requirement of 35 U.S.C. §112, which facilitates subsequent free public use of the invention, is the *quid pro quo* for the grant of a limited patent monopoly on a patentable invention." *Standard Oil Co. v. Montedison*, 664 F.2d 356 at 363 [212 USPQ 327 at 333](3d Cir. 1981).

4. 35 U.S.C. §120 provides that: "An application for patent for an invention disclosed in the manner provided by the first paragraph of Section 112 of this Title in an application previously filed in the United States . . . which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application. . . ."

5. "In terms of the statute, 35 U.S.C. §120, this means that, for an application to be entitled to the benefit of the date of a previously filed, copending application such application must contain a written description of the invention claimed in the second application which complies with the first requirement of the first paragraph of 35 U.S.C. §112." *Wagoner v. Barger*, 463 F.2d 1377 at 1380 [175 USPQ 85 at 86] (CCPA 1972).

6. "The invention claimed in the later application does not have to be described in the parent *in ipsis verbis* in order to satisfy the description requirement of Section 112 . . . . The question in cases in which the parent application does *not* contain language contained in the claims of the later application is whether the language which *is* contained in the parent application is the legal equivalent of the claim language, in the sense that the '*necessary and only reasonable* construction to be given the disclosure [in the parent application] by one skilled in the art,' *Binstead v. Littmann, supra*, is the same as the construction which such person would give the language in the claims of the later application." *Wagoner v. Barger, supra*, 463 F.2d 1377 at 1380 [175 USPQ 85 at 86-87]; emphasis in original.

7. The description in the application "must be so particular and definite that *from it alone, without*

experiment or the exertion of his own inventive skill, any person versed in the art to which it appertains could construct and use it." *Application of Brown*, 329 F.2d 1006 at 1011 [141 USPQ 245 at 249] (CCPA 1964); emphasis added.

8. The so-called doctrine of inherency provides that: "By disclosing in a patent application a device that inherently performs a function, operates according to a theory, or has an advantage, a patent applicant necessarily discloses that function, theory or advantage even though he says nothing concerning it." *Application of Smythe, supra*, 480 F.2d 1376 at 1384. However, that inherency must be apparent to one skilled in the art from the four corners of the patent application itself. This is evident from the rationale behind the inherency doctrine which the CCPA expressed as follows in *Smythe*, where the majority held that claims reciting the use of "inert fluid" were supported by a specification describing the use of "gas" as a segmentizing medium to separate blood samples in a blood analyzer:

> "Here, however, where the broader concept of using 'inert fluid' would naturally occur to one skilled in the art from reading appellants' description of the use and functions of the segmentizing media specifically described, we see no basis for denying appellants the claims which recite the segmentizing medium broadly as an 'inert fluid.' The alternative places upon patent applicants, the Patent Office, and the public the undue burden of listing, in the case of applicants, reading and examining, in the case of the Patent Office, and printing and storing, in the case of the public,

descriptions of the very many structural or functional equivalents of disclosed elements or steps *which are already stored in the minds of those skilled in the arts, ready for instant recall upon reading the descriptions of specific elements or steps.*

* * *

"A hypothetical situation may make our point clear. If the original specification of a patent application on the scales of justice disclosed only a 1-pound '*lead* weight' as a counterbalance to determine the weight of a pound of flesh, we do not believe the applicant should be prevented, by the so-called 'description requirement' of the first paragraph of §112, or the prohibition against new matter of §132, from later claiming the counterbalance as a 'metal weight' or simply as a 1-pound 'weight' although both 'metal weight' and 'weight' would indeed be progressively broader than 'lead weight,' including even such an undisclosed, but obviously art-recognized equivalent,'weight' as a pound of feathers. The broader claim language would be permitted *because the description of the use and function of the lead weight as a scale counterbalance in the whole disclosure would immediately convey to any person skilled in the scale art the knowledge that the applicant invented a scale with a 1-pound counterbalance weight, regardless of its composition.* Likewise, we find in the facts here a description of the use and function of the segmentizing medium

> *which would convey* to one skilled in the sample-analysis art the knowledge that applicants invented a sample analyzer with an inert *fluid* segmentizing medium." *Smythe, supra*, 480 F.2d at 1384; emphasis added.

9. A patent application which describes a process which inherently produces a product does *not* necessarily adequately describe the product. For example, in *Langer v. Kaufman*, 465 F.2d 915, 918 [175 USPQ 172, 173-174] (CCPA 1972), the Court held that the claims of a later-filed continuation-in-part application claiming a titanium trichloride composition having a gamma form X-Ray diffraction pattern was *not* supported by the specification (identified as the '488 specification) of the parent application, *notwithstanding the fact that a gamma X-Ray diffraction pattern was the inherent pattern of the product described in Run E in the '488 specification.* The CCPA responded to appellants' inherency argument as follows:

> "Appellants argue that it is the inherent pattern of the product described in Run E. To prove inherency, the burden is on appellants to show that the '*necessary and only reasonable* construction to be given the disclosure by one skilled in the art is one which will lend clear support to each positive limitation in the interference count.' . . . We do not think that that burden has been borne in this case.
>
> "The '488 specification disclosure does not necessarily lead to the conclusion that the Run E product was the gamma form. It could have been one of the other purple forms. The record shows that the various forms are distinguished by their respective X-Ray

> diffraction patterns, and since no information as to the pattern of the Run E product is given in the '488 specification, there is nothing to inevitably tie the Run E product to the gamma form . . . ." 465 F.2d at 918-919 [175 USPQ at 174]; emphasis in original.

10. It does *not* necessarily follow that a patent application which adequately describes a process which inherently will produce a later-claimed product, necessarily adequately describes that product. *Applt-ion of Edwards*, 568 F.2d 1349 at 1352 [196 USPQ 465 at 467-468] (CCPA 1978). It must be apparent to one skilled in the art, from the four corners of the application itself, that the claimed product will inherently result from the adequately-described process.

11. Concerning the sometimes-stated test of "whether the application originally filed in the Patent Office clearly conveyed in any way to those skilled in the art" the later claimed invention, such as in *Application of Smythe*, 480 F.2d 1376 at 1382 (CCPA 1982), it is not proper to interpret "in any way" so broadly as to permit the Section 112 description requirement to be satisfied by the description of examples which will inherently produce the later-claimed product if such inherency is not apparent to one skilled in the art from reading the specification itself. It is necessary that the application describe the claim limitations so clearly that persons of ordinary skill in the art will recognize *from the disclosure* that applicants invented the later-claimed subject matter. *Application of Wertheim*, 541 F.2d 257 at 262 [191 USPQ at 96] (CCPA 1976).

12. Plaintiff's argument that one skilled in the art would be enabled from the '954 specification to make the "equiaxed microstructure" product claimed in the '299 patent is unpersuasive for the reasons expressed as follows by the CCPA in response to a similar argument:

> "Appellants refer to 35 U.S.C. §112 as the presumed basis for this rejection and emphasize language therein about *enabling* one skilled in the art to *make* the invention, arguing therefrom that one skilled in the art would be enabled by the specification to make [the claimed compound] chlorpropamide. We find the argument unpersuasive for two reasons. First, it presumes some motivation for wanting to make the compound in preference to others. While we have no doubt a person so motivated would be enabled by the specification to make it, this is beside the point for the question is not whether he would be so enabled but whether the specification discloses the compound to him, specifically, as something appellants actually invented. We think it does not. . . ." *Application of Ruschig*, 379 F.2d 990 at 995 [154 USPQ 118 at 123]; CCPA 1967; words in brackets added.

13. In a line of cases beginning with *Application of Ruschig*, 379 F.2d 990 [154 USPQ 118] (CCPA 1967), the CCPA has "significantly tightened up on the application of the description requirement in the first paragraph of 35 U.S.C. §112." *Wagoner v. Barger*, *supra*, 463 F.2d at 1380 [175 USPQ at 87]. Accordingly, to the extent that there is any difference in the application of Section 112 in cases decided before and

after the CCPA's 1967 decision in *Ruschig*, the later decisions are controlling.

14. Plaintiff's U.S. Patent No. 4,179,299 is *not* entitled to the filing date of the application for U.S. Patent No. 4,312,954. The effective filing date of the 4,179,299 patent is May 1, 1978, the date the original application for that patent was first filed in the United States Patent Office.

15. This Court has jurisdiction and venue is proper. 28 U.S.C. §§1338(a) and 1400(b), and 35 U.S.C. §§281-285.

* * *

The following Findings of Fact and Conclusions of Law are hereby entered following this Court's review of the parties' briefs and arguments on defendants' motion for summary judgment of invalidity of U.S. Patent No.4,179,299.

1. This is a patent infringement suit, wherein the plaintiff charges the defendants with infringement of plaintiff's United States Patents Nos. 4,312,954 (the '954 patent) and 4,179,299 (the '299 patent).

2. Both the '954 patent and the '299 patent are directed to sintered silicon carbide ceramic bodies.

3. The effective filing date of the application for the '299 patent is May 1, 1979, pursuant to this Court's order granting defendants' motion that the '299 patent is not entitled to the June 5, 1975 filing date of the '954 patent.

4. Prior to May 1, 1977, i.e., more than one year prior to the effective filing date of the application for the '299 patent, plaintiff offered for sale and sold in the

United States ceramic bodies manufactured in accordance with one or more of Examples Nos. 1-30 of the '954 patent and falling within the scope of the claims of the '299 patent.

CONCLUSION OF LAW

1. This Court has jurisdiction and venue is proper. 28 U.S.C. §§1338(a) and 1400(b), and 35 U.S.C. §§281-285.

2. The patent statute [35 U.S.C. §102(b)] prohibits the grant of a patent for an invention which was 'on sale, in the United States more than one year prior to the filing date of a U.S. patent application. *Barmag Barmer Maschinenfabrik Ag v. Murata Machinery, Ltd.*, 731 F.2d 831 at 832 [221 USPQ 561 at 562-563] (Fed. Cir. 1984).

3. Summary judgment is as appropriate in a patent case as in any other. Where no genuine issue of material fact remains and the movant is entitled to judgment as a matter of law, the Court should utilize the salutary procedure of Fed.R.Civ.P. 56 to avoid unnecessary expense to the parties and wasteful utilization of the jury process and judicial resources. *Barmag Barmer Maschinenfabrik Ag v. Murata Machinery, Ltd., supra*, 731 F.2d at 835 [221 USPQ at 564].

4. United States Patent No. 4,179,299 and all claims thereof, are invalid pursuant to the "on sale" prohibition of 35 U.S.C. §102(b).

APPENDIX E

APPENDIX E

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SOUTHERN DISTRICT OF CALIFORNIA
BY DEPUTY

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

KENNECOTT CORPORATION, *Plaintiff,* *vs.* KYOCERA INTERNATIONAL, INC., a corporation; and KYOTO CERAMIC CO., LTD., a corporation, *Defendants.*	Civil Case No. 80-0516-R(M) JUDGMENT THAT UNITED STATES PATENT NO. 4,179,299 IS INVALID

This matter having come on for hearing on defendants' motion for summary judgment that United States Patent No. 4,179,299 is invalid pursuant to 35

U.S.C. §102(b) because plaintiff offered for sale and sold products within the scope of the claims of the patent more than one year prior to the May 1, 1978 effective filing date of the application for the patent; and

This Court having reviewed the briefs and heard the arguments made by the parties;

IT IS HEREBY ORDERED, ADJUDGED AND DECREED AS FOLLOWS:

1. That United States Patent No. 4,179,299 and all claims thereof, are invalid.
2. That portion of plaintiff's Complaint herein charging defendants with infringement of the 4,179,299 patent is dismissed, with prejudice.
3. Defendants' counterclaim seeking declaratory judgment that the 4,179,299 patent is invalid is granted.

This Court hereby designates this as a final judgment and directs its entry as such, pursuant to the provisions of Rule 54(b) of the Federal Rules of Civil Procedure. The Court makes the express determination that there is no just reason for delay in entering this final judgment, or in hearing the appeal upon it.

DATED: 12/17/86

JOHN S. RHOADES

United States
District Court Judge

Submitted By:

PAUL L. GARDNER
SAUL EPSTEIN
SPENSLEY HORN JUBAS & LUBITZ

By: Paul L Gardner 11-25-86
Paul L. Gardner

Attorneys for Defendants

APPENDIX F

APPENDIX F

Note: This Order has not been prepared for publication in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent.

United States Court of Appeals for the Federal Circuit

No. 87-1151

RECEIVED FEB 1 1 1988

KENNECOTT CORPORATION,

Plaintiff-Appellant,

vs.

KYOCERA INTERNATIONAL, INC. and KYOTO CERAMIC CO., LTD.,

Defendant-Appellee.

ORDER

A suggestion for rehearing in banc having been filed in this case,

UPON CONSIDERATION THEREOF, it is

ORDERED that the suggestion for rehearing in banc is declined.

FOR THE COURT:

Francis X Gindhart

Francis X. Gindhart,
Clerk

2/5/88

Date

cc: Mr. Clyde F. Willian
Mr. Paul L. Gardner

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT
FEB 5 1988
FRANCIS X. GINDHART
CLERK

APPENDIX G

APPENDIX G

(Patent Statutes, 35 U.S.C. §102, 111, 112, 113, 115, 119, 120 & 251)

§102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.
(July 19, 1952, c.950, 66 Stat. 797; July 28, 1972, Pub.L. 92-358, §2, 86 Stat. 502; Nov. 14, 1975, Pub.L. 94-131, §5, 89 Stat. 691.)

§111. Application for patent[1]

Application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Commissioner. Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned,

---

[1] Section catchline editorially supplied.

unless it is shown to the satisfaction of the Commissioner that the delay in submitting the fee and oath was unavoidable. The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.
(July 19, 1952, c. 950, 66 Stat. 798; Aug. 27, 1982, Pub.L. 97-247, §5, 96 Stat. 319.)

§112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.
(July 19, 1952, c. 950, 66 Stat. 798; July 24, 1965, Pub.L. 89-83, §9, 79 Stat. 261; Nov. 14, 1975, Pub.L. 94-131, §7, 89 Stat. 691.)

§113. Drawings

The applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented. When the nature of such subject matter admits of illustration by a drawing and the applicant has not furnished such a drawing, the Commissioner may require its submission within a time period of not less than two months from the sending of a notice thereof. Drawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or (ii) to supplement the original disclosure

thereof for the purpose of interpretation of the scope of any claim.
(July 19, 1952, c. 950, 66 Stat. 799; Nov. 14, 1975, Pub.L. 94-131, §8, 89 Stat. 691.)

§115. Oath of applicant

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority is proved by certificate of a diplomatic or consular officer of the United States, or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States, and such oath shall be valid if it complies with the laws of the state or country where made. When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him.
(July 19, 1952, c. 950, 66 Stat. 799; Aug. 27, 1982, Pub.L. 97-247, §14(a), 96 Stat. 321.)

§119. Benefit of earlier filing date in foreign country; right of priority

An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

No application for patent shall be entitled to this right of priority unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed in the Patent and Trademark Office before the patent is granted, or at such time during the pendency of the application as required by the Commissioner not earlier than six months after the filing of the application in this country. Such certification shall be made by the patent office of the foreign country in which filed and show the date of the application and of the filing of the specification and other papers. The Commissioner may require a translation of the papers

filed if not in the English language and such other information as he deems necessary.

In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application in the same foreign country instead of the first filed foreign application, provided that any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.

Applications for inventors' certificates filed in a foreign country in which applicants have a right to apply, at their discretion, either for a patent or for an inventor's certificate shall be treated in this country in the same manner and have the same effect for purpose of the right of priority under this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents, provided such applicants are entitled to the benefits of the Stockholm Revision of the Paris Convention at the time of such filing.
(July 19, 1952, c. 950, 66 Stat. 800; Oct. 3, 1961, Pub.L. 87-333, §1, 75 Stat. 748; July 28, 1972, Pub.L. 92-358, §1, 86 Stat. 501; Jan. 2, 1975, Pub.L. 93-596, §1, 88 Stat. 1949.)

§120. Benefit of earlier filing date in the United States

An application for patent for an invention disclosed in the manner provided by the first paragraph of

section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.
(July 19, 1952, c. 950, 66 Stat. 800; Nov. 14, 1975, Pub.L. 94-131, §9, 89 Stat. 691; Nov. 8, 1984, Pub.L. 98-622, Title I, §104(b), 98 Stat. 3385.)

§251. Reissue of defective patents

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

(July 19, 1952, c. 950, 66 Stat. 808.)

Supreme Court, U.S.
FILED
APR 20 1988
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No. 87-1592

IN THE

Supreme Court of the United States

OCTOBER TERM, 1987

KYOCERA INTERNATIONAL, INC.
and KYOTO CERAMIC CO., LTD.,

Petitioners,

v.

KENNECOTT CORPORATION,

Respondent.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

RESPONDENT'S BRIEF IN OPPOSITION

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27 pp

COUNTERSTATEMENT OF QUESTION PRESENTED

As stated by the petitioners, the question presented is seriously flawed, particularly in its opening clause which states, "[w]here it is admittedly impossible to discern the invention from a reading of a patent . . ." In fact, the invention is clearly identified and described in the parent '954 patent. All that the present controversy concerns is the admitted absence from the '954 patent of an express identification of an inherent property of the invention, namely, an equiaxed microstructure. Remarkably, the petitioners completely omit from their statement of the question presented and, for that matter, from their entire petition, any mention of the doctrine of inherency, the principal basis of the Federal Circuit's decision. Accurately stated, the question presented is as follows:

Did the Federal Circuit correctly find that the express disclosure in a subsequent patent application of an inherent property of a product disclosed in an earlier related patent application does not deprive the product of the benefit of the filing date of the earlier application, nor does the inclusion of a description of that property in later-filed claims change this result?

RULE 34.1(b) STATEMENT

Kennecott Corporation, the nominal respondent, was a real party in interest at the time the district court entered judgment in 1986, but it is no longer a real party in interest. Effective as of December 31, 1986, the name of Kennecott Corporation was changed to Kennecott Mining Corporation, and all assets of Kennecott Corporation which pertain to this suit were transferred to Stemcor Corporation, a Delaware corporation. As owner of the patents in suit, Stemcor Corporation is now a real party in interest.*

RULE 28.1 STATEMENT

Stemcor Corporation is now owned 99% by Standard Alaska Production Company, a Delaware Corporation, and 1% by The Standard Oil Co., an Ohio corporation. Standard Alaska Production Company is a wholly-owned subsidiary of The Standard Oil Co. The Standard Oil Co. is a wholly-owned subsidiary of BP America, Inc., a Delaware corporation. BP America, Inc. is a wholly-owned subsidiary of The British Petroleum Co. p.l.c., a British Company.

Stemcor Corporation has no subsidiaries or affiliates, other than subsidiaries which are directly or indirectly wholly owned. Stemcor Corporation is in the process of changing its name to The Carborundum Company.

---

* Effective as of May 7, 1987, the name of Kennecott Mining Corporation was changed to Industrial Holdings Corporation, and Industrial Holdings Corporation was sold to Shearson Lehman Brothers Holdings, Inc. Industrial Holdings Corporation is now a wholly-owned subsidiary of Shearson Lehman Brothers Holdings, Inc.

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No. 87-1592

IN THE

Supreme Court of the United States

OCTOBER TERM, 1987

KYOCERA INTERNATIONAL, INC.
and KYOTO CERAMIC CO., LTD.,

Petitioners,

v.

KENNECOTT CORPORATION,

Respondent.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

RESPONDENT'S BRIEF IN OPPOSITION

Respondent Kennecott Corporation respectfully requests that this Court deny the petition for a writ of certiorari, which seeks review of the judgment and opinion of the United States Court of Appeals for the Federal Circuit, reported at 835 F.2d 1419 and reprinted in the Appendix to the petition as Appendix B.[1]

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[1] The Appendix attached to the petition is referred to in this brief as "App. ____", and the petition itself is referred to as "Pet. at ____".

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

In addition to the sections of the Patent Statute reproduced in the Appendix (App. G), the following portions of the Constitution and the Patent Statute are relevant here:

U.S. Const. art. I, § 8, cl. 8

> The Congress shall have Power . . . to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries; . . . .

35 U.S.C. § 282

Presumption of validity; defenses

> A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity . . . .

COUNTERSTATEMENT OF THE CASE

A. Background Of The Patents Involved

The application for U.S. Patent No. 4,312,954 ("the '954 patent"), owned by respondent Kennecott Corporation ("Kennecott"),[2] was filed on June 5, 1975. It disclosed the invention of a sintered silicon carbide ceramic body. The application for the related U.S. Patent No. 4,179,299 ("the '299 patent"), also owned by Kennecott, was filed on May 1, 1978, and was designated a continuation-in-part ("CIP") of the '954 patent application. The CIP application also disclosed the invention of a sintered silicon carbide ceramic body. One of the ways that it differed from its parent application was that the CIP application expressly drew attention to the inherent property of an equiaxed microstructure.

B. The Proceedings In The District Court

Kennecott commenced this action against the petitioners herein, Kyocera International, Inc. and Kyoto Ceramic Co., Ltd. (collectively, "Kyocera"), asserting infringement of both the '954 patent and the '299 patent. In its defense, Kyocera claimed that the '299 patent is invalid under 35 U.S.C. § 102(b).[3]

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[2] For a complete explanation of the ownership of title to the patents in suit, please refer to the statements in compliance with Rules 34.1(b) and 28.1, included at page ii of this brief. All of the interested parties on behalf of respondent are collectively referred to herein as "Kennecott".

[3] § 102(b) provides that a patent is invalid if the invention disclosed therein was on sale in this country more than one year prior to the filing date of the patent. (App. G1)

The only way that Kyocera could prevail on this defense was to prove that the '299 patent was not entitled to an effective filing date of June 5, 1975, the date that the application for the '954 patent was filed. This, in turn, required that Kyocera show that the property of an equiaxed microstructure was not described in the parent application in accordance with the description of the invention requirement of 35 U.S.C. § 112 ("the description requirement").[4]

Kyocera moved and petitioned for reconsideration *three* times before finally, on the fourth try, it convinced the district court to rule in its favor on the filing date issue. However, in doing so the district court acknowledged that, "I wouldn't be surprised that some court, somewhere, will tell me that I'm all wet." (Tr. Nov. 17, 1986, p. 8, lines 23-25) Nonetheless, the court found that the effective filing date of the '299 patent was May 1, 1978, not June 5, 1975.

In light of this ruling, Kennecott filed an admission that prior to May 1, 1977 (i.e., more than one year prior to what was found to be the effective filing date of the '299 patent), Kennecott offered for sale and sold in the United States silicon carbide ceramic bodies manufactured in accordance with one or more of examples 1-30 of the '954 patent and falling within the scope of the claims of the '299 patent. Accordingly, the district court entered summary judgment that the claims of the '299 patent were invalid under § 102(b).

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[4] § 112 provides, *inter alia*, that the specification of a patent shall contain a "written description of the invention . . ." (App. G3)

C. The Federal Circuit's Reversal Of The District Court

In its decision reversing the ruling of the district court, the Federal Circuit pointed to five key facts that are admitted:

> 1. the pertinent silicon carbide ceramic body described in the application for the '954 patent has an equiaxed microstructure;
>
> 2. the application for the '954 patent does not mention the equiaxed microstructure property or state the requirements for forming such a microstructure;[5]
>
> 3. the Kennecott inventors knew that the pertinent ceramic body disclosed in the application for the '954 patent had an equiaxed microstructure, and it was known that such ceramics could have such a microstructure;
>
> 4. examples 1-30 in the application for the '954 patent each produces a ceramic body having an equiaxed microstructure; and
>
> 5. the method set forth in the application for the '954 patent using the pertinent silicon carbide invariably produces a ceramic body having an equiaxed microstructure. (App. B4)[6]

---

[5] Kennecott does not admit that the requirements for forming an equiaxed microstructure are not stated in the application for the '954 patent. They are stated in examples 1-30 set forth therein, each of which, if repeated, invariably produces a silicon carbide ceramic body having an equiaxed microstructure.

[6] The Federal Circuit's recitation of these five important facts identified the pertinent ceramic body as one that is "high-alpha" silicon carbide. This is to distinguish from lower-alpha or beta silicon carbide, which are not part of the preferred embodiment or examples 1-30 of the '954 patent.

The Federal Circuit rejected the district court's reading into § 112 of the limitation that "to meet the description requirement, one reading the specification must know from the 'four corners' of the document, without recourse to information outside the specification, that the ceramic body has an equiaxed microstructure." (App. B5) The appellate court noted that, "[t]he Court of Customs and Patent Appeals [the Federal Circuit's predecessor court] [("CCPA")] has long recognized that an invention may be described in different ways and still be the same invention." (App. B9)

One of these different ways is through what is known as an inherent disclosure. For example, in *In re Nathan*, 328 F.2d 1005 (C.C.P.A. 1964), "the court held that the later-added limitation to the claims of the compound's alpha orientation was 'an inherent characteristic' of the claimed subject matter, and reversed a new matter rejection." (App. B9) Based upon *Nathan* and other applicable precedent, the Federal Circuit concluded as follows:

> In the case at bar the additional description [of an equiaxed microstructure] was not of a new use, but of the existing physical structure of the product. On the basis of this precedent, the inclusion of the existing microstructure as a descriptive term in the '299 claims does not cause the '299 claims to lose their entitlement to the date of the first-filed '954 application. (App. B10)

In summary, the court emphasized that the doctrine of inherency applies to the determination of whether the description requirement of § 112 is satisfied:

> The disclosure in a subsequent patent application of an inherent property of a product does not deprive that product of the benefit of an earlier filing date. Nor does the inclusion of a description of that property in later-filed claims change this reasonable result. (App. B11)

The Federal Circuit panel unanimously reversed the district court's grant of summary judgment, concluding that the district court erred in holding that the '299 claims were not entitled to the filing date of the '954 patent. (App. B11) Kyocera petitioned the Federal Circuit to reconsider, en banc, its decision. This petition was summarily denied after briefing by both parties. (App. F1-F2)

SUMMARY OF REASONS FOR DENYING THE WRIT

Kyocera's petition asks this Court to exercise its certiorari jurisdiction to review a decision that was carefully considered and correctly decided. Applying the well-established doctrine of inherency, the Federal Circuit correctly held that an inherent disclosure of a property of an invention fully satisfies the description requirement, so that a subsequent express disclosure of the property is entitled to the original filing date.

The courts have repeatedly recognized that description requirement questions are particularly fact-intensive. Therefore, this Court's consideration of the description requirement on the facts of this case would offer little guidance to the lower courts. In addition, the courts have had no trouble in applying the doctrine of inherency to description requirement questions, nor have they disagreed on its application in such circumstances. This Court should not waste its scarce resources on the limited and unimportant question posed here.

There is no conflict between the Federal Circuit's decision here and any of the Supreme Court cases or the

CCPA decision relied upon by Kyocera. The cited cases of this Court were decided long before § 112 was enacted, and, as will be illustrated at length hereafter, they are otherwise inapposite. Likewise, the CCPA decision is distinguishable both on the law and on its facts.

The Federal Circuit reached a fair result in according the '299 patent the filing date of the '954 patent. In order to encourage and stimulate invention, inventors must not be straitjacketed by unduly restrictive disclosure requirements. The doctrine of inherency ensures that the public interest underlying the description requirement is satisfied, while it also allows inventors necessary latitude in disclosing their inventions. Indeed, another result here would create chaos in patent law and effectively destroy the doctrine of inherency.

The lack of merit in Kyocera's petition is perhaps best illustrated by the deficiencies of its own brief, beginning with the erroneous premise that the invention is not described in the '954 patent. Furthermore, Kyocera's attempt to read a "four corners" restriction into the express language of § 112 has no foundation, and its attempt to assign the purpose of § 112 as a whole to the description requirement alone is in error. The ultimate deficiency is Kyocera's failure to discuss the doctrine of inherency, the express basis of the Federal Circuit's decision.

Kyocera has shown dauntless persistency with respect to this question by filing multiple motions and petitions for reconsideration. Its petition here represents yet another attempt to argue a narrow and simple question that was correctly decided by the Federal Circuit and is not worthy of this Court's time and consideration. The writ should be denied.

REASONS FOR DENYING THE WRIT

A. The Federal Circuit Reached A Correct Conclusion That Is In Accord With An Established Line Of Precedent

The description requirement is one of three requirements of the first paragraph of § 112.[7] The description requirement ensures "that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him." *In re Edwards*, 568 F.2d 1349, 1351 (C.C.P.A. 1978). Compliance with the requirement is judged "from the perspective of the person skilled in the relevant art." *In re Smith*, 481 F.2d 910, 914 (C.C.P.A. 1973).

Because there is an infinite variety of ways in which an invention may be "described", the law is well-settled that the inventor's possession of his invention may be conveyed "in any way" to those skilled in the art. *In re Smythe*, 480 F.2d 1376, 1382 (C.C.P.A. 1973). *See also In re Voss*, 557 F.2d 812, 817 (C.C.P.A. 1977) ("How the application of the parent achieves compliance [with the description requirement] is immaterial.")

One of the ways in which the specification may describe the invention is, of course, by an express disclosure. In addition, however, an inherent disclosure of an invention

[7] The other requirements are known as the enablement and best mode requirements, each of which concerns a different aspect of disclosure. However, although Kyocera's petition tends to gloss over this fact, as the Federal Circuit explained in this case, "[t]he purpose of the description requirement . . . is to state what is needed to fulfill the enablement criteria. These requirements may be viewed separately, but they are intertwined." (B6)

equally satisfies the description requirement. The cases that apply the so-called doctrine of inherency to the description requirement are legion. Among the most pertinent here are those cases relied upon by the Federal Circuit in its thoughtful analysis of the issue before it, including, *In re Nathan*, 328 F.2d 1005 (C.C.P.A. 1964) (App. B9); *In re Reynolds*, 443 F.2d 384 (C.C.P.A. 1971) (App. B8); and *Edwards*, 568 F.2d at 1349 (App. B7-B8).

Another apt case, having facts very analogous to those at bar, is the decision of the Ninth Circuit in *Indiana General Corp. v. Lockheed Aircraft Corp.*, 408 F.2d 294 (9th Cir. 1968). The invention disclosed in the parent application in *Indiana General* embodied a method for making a manganese-magnesium ferrite material. Although the application included examples of how to make the material, it did not mention one of its properties, a square hysteresis loop. This property was subsequently expressly described in a CIP application. *Id.* at 299. In the interim between the filing of the parent and the CIP applications, the patentee sold products covering the invention, including the square hysteresis loop. The asserted claims of the CIP were held invalid on a motion for summary judgment because the lower court did not accord the CIP application the filing date of the parent. *Id.* at 295-96. The Ninth Circuit reversed for the same reasons that the Federal Circuit did so here:

> The fact that an inventor of a specific compound subsequently discloses in a continuation in part application an additional property or use of the compound or composition does not deprive the inventor of the filing date of the first application disclosing the compound . . . . The properties of a given substance are immutable.

Id. at 298-99. *See also In re Magerlein*, 346 F.2d 609, 611-12 (C.C.P.A. 1965); *Ralston Purina Co. v. Far-Mar-Co*,

Inc., 586 F. Supp. 1176, 1220 (D. Kan. 1984), *modified on other grounds*, 772 F.2d 1570 (Fed. Cir. 1985).

Ignoring all of this sound precedent and all of the compelling reasons advanced by the Federal Circuit as to why Kyocera's arguments lack merit, Kyocera hinges its petition on its oft-repeated argument that the description requirement mandates that the invention be described within the "four corners" of the patent. This argument is as deficient now as it was when Kyocera first asserted it. As noted hereinbefore, the invention of a silicon carbide ceramic body *is* expressly described within the "four corners" of the '954 patent; all that is at issue is the description of the equiaxed microstructure. The equiaxed microstructure also *is* described within the "four corners" of the '954 patent; however, it is inherently, rather than expressly, described.

With respect to the Patent Statute, this Court has been particularly careful to caution that, "courts 'should not read into the patent laws limitations and conditions which the legislature has not expressed.' " *Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980) (construing § 101 of the Statute and quoting *United States v. Dubilier Condenser Corp.*, 289 U.S. 178, 199 (1933)). A plain reading of § 112 illustrates that there is *no* "four corners" limitation in the description requirement. Thus, Kyocera's argument to the contrary (Pet. at 14-16) is wholly devoid of merit.[8]

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[8] Kyocera's repeated references to § 102(b) and its purpose is a red herring (e.g., Pet. at 15) because the Federal Circuit's decision in no way compromises the purpose of § 102(b). Indeed, Kennecott's allegedly invalidating sales of ceramic bodies, which were manufactured in accordance with the preferred teachings and examples 1-30 of the '954 patent, were made *after* the application for the '954 patent was filed and *before* the application for the '299 patent existed.

Indeed, there is ample judicial authority for looking beyond the "four corners" of a patent when considering whether the description requirement is satisfied.[9] *In re Edwards*, 568 F.2d at 1352-54 (inferences that could be drawn from examples in application); *Standard Oil Co. (Indiana) v. Montedison, S.p.A.*, 664 F.2d 356, 371 (3d Cir. 1981), *cert. denied*, 456 U.S. 915 (1982) (examination of results obtained by following examples set forth in application); *In re Voss*, 557 F.2d at 818 (consideration of findings made in third party civil litigation); *In re Nathan*, 328 F.2d at 1008-09 (use of affidavit which described result obtained by following example set forth in application).

The reason for this clear authority is simple. By definition, an inherent description is not an express one. Thus, an inherent description, such as of an "equiaxed microstructure", requires that the invention be described in a manner *other than express language*, because if there were an express disclosure, the issue of inherency would not need to be considered. The Federal Circuit had before it a classic case for applying the doctrine of inherency, and it correctly followed established precedent in deciding the description requirement question.

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[9] Similarly, the law is well-settled that the enablement requirement of § 112 is satisfied even though reasonable experimentation may be necessary. *See e.g., DeGeorge v. Bernier*, 768 F.2d 1318, 1323 (Fed. Cir. 1985). In this case, *no* experimentation is necessary to obtain a silicon carbide ceramic body having an equiaxed microstructure. And as the Federal Circuit pointed out in this case, the description and enablement requirements "may be viewed separately, but they are intertwined." (App. B6) *See also In re Barker*, 559 F.2d 588, 594 (C.C.P.A. 1977), *cert. denied*, 434 U.S. 1064 (1978) (Rich, J., concurring) (description and enablement are "distinct though commingled requirements").

B. The Question Presented Is Not An Important One

By the very nature of the inquiry, each description question turns on its own specific facts. *In re Edwards*, 568 F.2d 1349, 1352 (C.C.P.A. 1978). The pertinent language of § 112 is very broad: ". . . a written description of the invention", no doubt to accommodate the variety of ways by which the description requirement may be satisfied. *See Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980) (stating that "Congress plainly contemplated that the patent laws would be given wide scope" in using broad terms to define patentable subject matter).

In recognition of the flexible approach that must be taken with description questions, the Federal Circuit has stated that, "Precisely how close the original description must come to comply with the description requirement of 35 U.S.C. § 112 must be determined on a case-by-case basis." *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985). Because of this limitation, the courts have long noted that decisions on description requirement questions are of limited precedential value. *In re Driscoll*, 562 F.2d 1245, 1250 (C.C.P.A. 1977).

In view of the fact-intensive nature of description questions, even if this Court were to consider this case on its undisputed facts, the Court's decision would be of limited direction to the lower courts. In addition, the lower courts have not had any disagreement among themselves as to how the description requirement may be satisfied, nor have they indicated that this Court's intervention is necessary to resolve confusion or difficulty on their part.

Accordingly, the Court's consideration of this narrow question, lacking in importance, would constitute a waste of this Court's already scarce resources.

C. The Decision Below Does Not Conflict With Decisions Of This Court Or Precedent In The Federal Circuit

Arguing that the Federal Circuit's decision is at odds with judicial precedent, Kyocera cites three decisions by this Court, each at least 50 years old, and one decision of the CCPA. Kyocera has only now raised the Supreme Court cases, none of which is on point. In fact, no reported decision of the Federal Circuit cites any of these cases in deciding a description requirement issue. In its discussion of the cases, Kyocera itself equivocally contends that there "appears" to be an inconsistency with the Federal Circuit's decision. (Pet. at 16, 18) Clearly, even Kyocera realizes that its argument lacks merit.

Permutit Co. v. Graver Corp., 284 U.S. 52 (1931), was decided over twenty years before the enactment of the 1952 Patent Act, which includes § 112. The case is also distinguishable on its facts. In *Permutit*, the free zeolite bed was separate from, and *not* inherent in, the water softening apparatus. *Id.* at 55. Here, the equiaxed microstructure is an inherent property of the silicon carbide ceramic body disclosed in the parent application. In addition, the absence in the *Permutit* patent of any reference to a free, rather than a locked, zeolite bed raised no implication that a free bed was important. *Id.* at 57. Here, one skilled in the art need not rely on implication—he will invariably obtain a silicon carbide ceramic body having an equiaxed microstructure if he follows the preferred teachings or any one of examples 1-30 set forth in the '954 patent.[10]

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[10] Kyocera's quotation from *Permutit* suggesting that drawings may not be used when interpreting the specification or claims is

(Footnote continued on following page)

Schriber-Schroth Co. v. Cleveland Trust Co., 305 U.S. 47 (1938), is likewise not in conflict with the Federal Circuit's decision in this case. In *Schriber-Schroth*, although flexibility was apparently an inherent property of the material out of which the claimed webs were made, the specification expressly taught to the contrary that the webs were "extremely rigid". *Id.* at 55. Here, by contrast, the preferred teachings and examples 1-30 of the '954 patent all invariably lead to a silicon carbide ceramic body having an equiaxed microstructure. *See Ralston Purina Co. v. Far-Mar-Co, Inc.*, 586 F. Supp. 1176, 1219-20 (D. Kan. 1984), *modified on other grounds*, 772 F.2d 1570 (Fed. Cir. 1985) (distinguishing *Schriber-Schroth* on the same basis stated here and finding that an inherent disclosure was full support for a subsequent express disclosure).

In *General Electric Co. v. Wabash*, 304 U.S. 364 (1938), the description requirement was not even in issue. Rather, the Court was there concerned with the requirement, which now constitutes the *second* paragraph of § 112, that a patent application must contain claims "particularly pointing out and distinctly claiming" the invention. Thus, the Court considered whether or not the claims were too indefinite. *Id.* at 369. The Court's passing reference to the description in the specification, *id.* at 373, which was not an issue before the Court, was made in the context of its discussion of the claims. In this case, there is no dispute that, with the exception of the description requirement, *all* of § 112 is satisfied.

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[10] *continued*
inapposite. Here there is not an "entire absence of description of the invention" as there was in *Permutit*. *Id.* at 60. Rather, in this case there is an inherent disclosure of a property of the invention.

Kyocera's petition also refers to a CCPA decision, *Langer v. Kaufman*, 465 F.2d 915 (C.C.P.A. 1972). Again, Kyocera demonstrates its lack of conviction by stating that *Langer* is "apparently" irreconcilable with the Federal Circuit's decision here. (Pet. at 20) As the Federal Circuit has already explained, there is no inconsistency between *Langer* and this case; *Langer* was an interference case which concerned a different issue, constructive reduction to practice of the invention. (App. B10-B11) In addition, in *Langer* the court held that there was no inherency because the inventor did not appreciate the invention embodied in the product described in the parent. *Id.* at 918. Indeed, "[a]ll the other evidence [was] to the contrary." *Id.* at 920. In this case, however, Kyocera has admitted that the Kennecott inventors knew they had obtained an equiaxed microstructure before the application for the '954 patent was even filed.

Furthermore, the "necessary and only reasonable construction" language in *Langer*, relied on by Kyocera, refers to predictability of result. Thus, as explained in *Langer*, "[t]he '488 specification disclosure does not necessarily lead to the conclusion that the Run E was the gamma form. It could have been one of the other purple forms." *Id.* at 918. By contrast, here Kyocera has admitted that there is absolute predictability of result if one skilled in the art follows the preferred teachings or repeats any one of examples 1-30 of the '954 patent.

Kyocera has failed to raise even the slightest suggestion of a conflict between the Federal Circuit's decision here and the prior decisions of this Court or any other tribunal.

D. The Federal Circuit Reached A Fair Decision

The Federal Circuit's decision recognizes the flexibility that inventors must be permitted in describing and claiming their inventions. In addition, it is in harmony with the fundamental principles of United States patent law that a patent is presumed valid and that the party alleging patent invalidity bears the burden of proof, and that burden never shifts. 35 U.S.C. § 282.

Because the Federal Circuit found that the inherent disclosure in this case was adequate, this does not mean that there are no limits on the doctrine of inherency. Rather, the inherent disclosure was acceptable here because of the very important admitted facts, which included contemporaneous appreciation, invariability of result, and the knowledge of those in the ceramics art that silicon carbide ceramic bodies may have equiaxed microstructures. (App. B4) It was further admitted that as a matter of course, such a person skilled in the art would examine the microstructure of a new ceramic body and, in this case, would find an equiaxed microstructure. Based upon these facts, the Federal Circuit was satisfied that the necessary information was reasonably conveyed to one of skill in the art, and the inherent disclosure met the description requirement.

Such a result was eminently reasonable and fair because possession of the invention was ensured, obtaining an equiaxed microstructure was inevitable, and an understanding of the invention by one skilled in the art was purely routine. Thus, application of the doctrine of inherency in no way sacrificed the purpose underlying the description requirement.

E. Any Result Other Than That Reached By The Federal Circuit Would Create Chaos In Patent Law

Particularly since it was the basis of the Federal Circuit's decision, it is of marked interest that Kyocera's petition does not address the doctrine of inherency. Perhaps one reason why the petition avoids any such discussion is, as noted above, that Kyocera is essentially advocating the destruction of the doctrine of inherency. Such a result would have a calamitous effect on patent law as it is presently understood and practiced and as it has in the past been understood and practiced.

If there were no doctrine of inherency, inventors would be strictly confined to unreasonably narrow rules for describing their inventions and any deviations therefrom, however slight, would result in a loss of patent rights. This would hardly fulfill the intention of the Framers of the Constitution who gave Congress the power "to promote the Progress of Science and useful Arts . . .", U.S. Const. art I, § 8, cl. 8, nor the intention of Congress which exercised its power by enacting a broadly worded description requirement.

In addition to placing in jeopardy innumerable extant patents, destruction of the doctrine would overrule an unbroken line of well-reasoned, fair, and consistent authority. This authority would be replaced by precedent that would encourage patent infringers to take advantage of a technical loophole and to freely reap the benefits of other persons' inventions, which are the result of substantial investments of energy, time, and money.

F. Kyocera's Petition Is Without Merit

Three of the basic flaws of Kyocera's petition have already been noted—its premise that the invention is not disclosed in the '954 patent, its failure to recognize or discuss the doctrine of inherency, and its attempt to read a "four corners" limitation into the description requirement.

In addition, Kyocera tries to build a case by noting that predecessor statutes to the 1952 Patent Act also had description requirements. Such discussion does little to advance its position, however. In his concurring opinion in *In re Barker*, Judge Rich, now of the Federal Circuit, responded with skepticism to the majority's similar analysis of the predecessor description requirements. *In re Barker*, 559 F.2d 588, 594 (C.C.P.A. 1977), *cert. denied*, 434 U.S. 1064 (1978) (Rich, J., concurring). He even noted that though some of the words from predecessor statutes were carried over into § 112, "they are inappropriate to some situations . . ." *Id.* Indeed, perhaps what is most notable about Kyocera's historical view is that it clearly shows that the description requirement has always been very broadly worded and that there is not now and never has been any "four corners" restriction in § 112. *See Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980).

Kyocera's petition also erroneously requires that the purpose of § 112 *as a whole* be fulfilled by the description requirement alone. In fact, however, § 112 also contains enablement, best mode, and definiteness requirements, each of which also contributes to the overall purpose of § 112 that an inventor inform the public of his invention in exchange for a patent and its accompanying rights of exclusion. There is no dispute that the '954 patent satisfies each of these other requirements.

Kyocera's petition lacks force and credibility because it is misleading, and it is premised on erroneous assertions. In sum, the petition is without merit.

CONCLUSION

Kyocera's petition asks this Court to overturn an established line of authority through which the doctrine of inherency has flourished. The doctrine of inherency is necessary and it is fair. Accordingly, the writ should be denied.

Respectfully submitted,

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No. 87-1592

(3)

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1987

KYOCERA INTERNATIONAL, INC.
and KYOTO CERAMIC CO., LTD.,

Petitioners,

vs.

KENNECOTT CORPORATION,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

PETITIONERS' REPLY BRIEF

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Petitioners, Kyocera International, Inc. and Kyoto Ceramic Co., Ltd. (collectively, "Kyocera"), respectfully submit this Reply Brief in support of their Petition for a Writ of Certiorari filed March 21, 1988 ("Petition"), and in reply to the Brief in Opposition ("Opposition") filed on behalf of respondent, Kennecott Corporation ("Kennecott").[1]

REPLY ARGUMENT

A. There Is No "Express" Or "Inherent" Description Of An Equiaxed Microstructure In The '954 Patent Application

Section 112 unequivocally requires that "[t]he specification shall contain a written description of the invention." The '954 patent application fails to satisfy this written description requirement because the application contains *no* written description, express or inherent, of the claimed equiaxed microstructure.

As Kennecott concedes, the '954 patent application contains *no* express mention (description) of an equiaxed microstructure. *See* Opposition, at page i, first paragraph, lines 6-9. Thus, the claimed invention is *not* expressly described (*i.e., in ipsis verbis*) in the '954 patent application. *See In re Edwards*, 568 F.2d 1349, 1351-52 (CCPA 1978); Petition, at page 15, n.13.

The '954 patent application also fails to provide any "inherent" written description of an equiaxed microstructure since it is uncontroverted that *no one* reading the '954 patent application would or could know that a product formed as set out in the application has an equiaxed microstructure. That is, the '954 application contains *no* language whatsoever from which a skilled artisan can discern that a product formed will have an

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[1] In accordance with Rule 28.1 of the Rules of the Supreme Court, the parent companies, subsidiaries (other than wholly owned subsidiaries) and affiliates of Kyocera are set forth in the Petition, Appendix A at A1.

equiaxed microstructure. *See* Petition, Appendix D at D3, Finding 10; Appendix B at B4. In the words of the "inherent disclosure" cases, the application does *not* include any language whose "necessary and only reasonable construction" can be said to be the "legal equivalent" of the claimed "equiaxed microstructure" language. *Wagoner v. Barger*, 463 F.2d 1377, 1380 (CCPA 1972); Petition, at page 15, n.13 (discussing principles underlying what Kennecott refers to as the "inherent disclosure" cases). The existence of an equiaxed microstructure is *not* conveyed *in any way* to the reader of the patent application.[2]

This should be contrasted with a number of the "inherent disclosure" cases relied on by Kennecott. For example, in *In re Voss*, 557 F.2d 812, 818 (CCPA 1977), cited by Kennecott at pages 9 and 12 of the Opposition, the CCPA looked at all relevant evidence before concluding that a skilled artisan reading the patent specification would have understood the term "glass-ceramic material" used in the specification to mean a "crystal content . . . [of] at least 50% by weight" as set out in a patent claim:

> On this record, we conclude that the "at least 50%" limitation in appellant's claims merely quantifies the percentage crystallinity one of ordinary skill in the

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[2] Kennecott cites *In re Smythe*, 480 F.2d 1376, 1382 (CCPA 1973), for the statement that the invention can be conveyed "in any way." *See* Opposition, at page 9, second paragraph, lines 1-5. It is thus important to note that in *Smythe*, the CCPA held that the claimed limitation of "an 'inert fluid' would naturally occur to one skilled in the art *from reading appellants' description . . . of the segmentizing media specifically described*" in the patent specification. *Id.*, 480 F.2d at 1384 (emphasis added). The description *in the specification* would thus be understood by the skilled artisan *reading the specification* as encompassing the claimed "inert fluid" limitation. The "way" that the invention was conveyed was, as it must be under Section 112, by the description in the specification.

> art *at the time* would have attributed to the term "glass-ceramic material." *Id.*, 557 F.2d at 819 (emphasis in original).

The term "glass-ceramic material" was thus the "legal equivalent" of (or another way of referring to) the claimed "at least 50%" crystal content.

Kennecott argues that the '954 patent application should nonetheless be held to "inherently" contain a "written description of the invention [an equiaxed microstructure]" as Section 112 expressly requires, because the existence of an equiaxed microstructure, could be ascertained if one formed products by following the examples in the '954 patent application and then examined such samples under a microscope. *See* Opposition, at page 9, §A. But, as fully explained in the Petition, such a construction of Section 112 is contrary to the plain meaning of the statute, would frustrate the objectives of the statute (and of Section 102(b)), and is inconsistent with the spirit of this Court's decisions applying Section 112's predecessor statute as well as with precedent of the Federal Circuit.[3]

B. The Federal Circuit's Interpretation Of Section 112's Description Requirement *Is* Contrary To The Plain Meaning Of The Statute

Kennecott argues that requiring an invention to be described in a patent specification would be "to read a 'four corners' restriction into the express language of

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[3] Although in a very few pre-Federal Circuit cases, courts have departed from the plain meaning of the statute, the instant case is the first case in which the Federal Circuit has done so. *See e.g., Indiana General Corp. v. Lockheed Aircraft Corp.*, 408 F.2d 294 (9th Cir. 1968) (discussed by Kennecott in its Opposition at page 10). This Federal Circuit decision, if not overturned by this Court, would be binding precedent in *all* future cases in any and all jurisdictions. *South Corp. v. United States*, 690 F.2d 1368, 1369-71 (Fed. Cir. 1982).

§112." *See* Opposition, at page 8, second full paragraph, lines 4-6. To the contrary, however, such a restriction is explicitly stated in the statute which requires that:

> The *specification* shall contain *a written description of the invention* . . . (emphasis added).

It is Kennecott that seeks to read the "[t]he *specification* shall contain" (four corners) limitation out of the statute.[4] The plain meaning of the statute is that *the specification* must include a written description of the invention. Resort to matters outside the specification to identify and describe the invention is contrary to the statute's plain meaning.

C. Reversal By This Court Would Return The Description Requirement To Where It Was Before The Federal Circuit's Serious Departure In This Case From The Plain Meaning Of The Statute

Kennecott further argues that reversal of the Federal Circuit's decision below "would create chaos" by "the destruction of the doctrine of inherency." *See* Opposition, at page 18, §E. That statement is completely irresponsible and certainly wrong. Following the plain meaning of Section 112 by requiring that a patent specification contain a "written description of the invention" will only create order and predictability to guide all those persons desiring to file patent applications and/or evaluate patents and patent applications. Moreover, such a decision would be absolutely consistent with

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[4] Kennecott's citation to *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 65 L.Ed.2d 144, 149 (1980), to support its claim that matters outside the patent specification may be used to describe the invention under Section 112 is not understood. *See* Opposition at page 19, second paragraph, last six lines. *Chakrabarty* did not address that issue whatsoever.

the body of case law — existing before the Federal Circuit's serious departure in this case from the plain meaning of the statute — demonstrating that the "doctrine of inherency" is intended simply to allow applicants latitude and flexibility in selecting language for describing their invention. It was not intended to enable applicants to evade entirely Section 112's description requirement by failing to describe the claimed invention in any way (*i.e.*, either expressly or by language understood by the skilled artisan to refer to the claimed invention).

D. The Question Presented Herein *Is* Critical

Kennecott argues that the question presented herein is not important because "each description question turns on its own facts." *See* Opposition, at page 13, first paragraph, lines 1-2. That is like saying that fundamental constitutional rights are not important because each alleged violation of such a right turns on its own facts. *See Schlesinger v. Councilman*, 420 U.S. 738, 755, 43 L.Ed.2d 591, 607 (1975) ("The precise content of constitutional rights almost invariably turns on the context of fact and law in which they arise"). This Petition seeks a Writ to review the interpretation of Section 112's description requirement to guide *all* cases in which a skilled artisan cannot discern the invention from reading the patent specification. It is, as explained in the Petition, a critical issue which arises in a great number of contexts. *See* Petition, at pages 12-13, paragraph spanning both pages.

E. The Federal Circuit's Interpretation Of Section 112's Description Requirement *Is* In Conflict With (A) This Court's Decisions Applying Section 112's Predecessor Statute, And (B) The Federal Circuit's Own Precedent

Kennecott argues that the Federal Circuit's decision below is not in conflict with this Court's decision in *Permutit Co. v. Graver Corp.*, 284 U.S. 52, 76 L.Ed. 163 (1931), because that case was decided under the statutory predecessor to Section 112 and the free zeolite bed was not inherent in the water softening apparatus. *See* Opposition, at page 14, second paragraph. That argument is devoid of merit. The description requirement of Section 112's predecessor, like the present Section 112, demanded that the patent specification contain a "written description" of the invention. *See* Petition, at page 10, n.10. The interpretation of this statutory language by this Court in *Permutit* is thus quite pertinent precedent for construing like language carried over into Section 112.[5] And the free zeolite bed, though possibly not inherent, was in fact explicitly shown in the drawings. But that was inadequate in *Permutit* because there still was no "written description" of the invention. The same remains true here as there is an entire absence of any mention or description of the claimed equiaxed microstructure in the '954 patent application.

Kennecott argues that the Federal Circuit's decision below is not in conflict with this Court's decision in *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U.S. 47, 83 L.Ed. 34 (1938), because the patent specification there stated that the webs were "extremely rigid" not "laterally flexible" as set out in the claims. *See* Opposition, at page 15, first paragraph. That argument is also meritless.

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[5] Section 112 has not been construed by this Court since the passage of the 1952 Patent Act, 35 U.S.C. Sections 1 *et seq.*

Kennecott admits (as it must) that the claimed lateral flexibility of the webs *was* an inherent property of the webs. *Id.* Nonetheless, that was insufficient as there was no description of that inherent property in the specification. The same is true here. "A sintered ceramic body . . . having a predominantly equiaxed microstructure" as set out in the claims of the '299 patent is *not* described by Kennecott in the much earlier '954 application which failed to refer to such microstructure either expressly or by implication.

Kennecott argues that the Federal Circuit's decision below is not in conflict with this Court's decision in *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369, 82 L.Ed. 1402, 1405 (1937), because in that case the description requirement was allegedly not an issue. *See* Opposition, at page 15, second paragraph. That is simply wrong. In *Wabash*, this Court assumed (*arguendo*) that the product claims could be refined by reference to the process in the specification (*i.e.*, that the claims could be read broadly so as to include anything in the written description of the process). This Court nonetheless found the claims defective, because the description of the process in the specification was silent as to the nature of the filament of the claimed product. 304 U.S. at 373, 82 L.Ed. at 1407-08. The same is true here. The description of the Kennecott process in the '954 patent application, like the description of the Kennecott product, is painfully silent as to the nature of the microstructure of the claimed ceramic body. There is thus no support in the '954 patent application for a "sintered ceramic body . . . having an equiaxed microstructure." The claims are defective here as they were in *Wabash*.

Kennecott argues that the Federal Circuit's decision below is not in conflict with its precedent, particularly, *Langer v. Kaufman*, 465 F.2d 915, 918 (CCPA 1972), because that case was an interference case concerning the issue of "constructive reduction to practice," the inventor

did not actually appreciate his claimed product invention at the time the patent application was filed, and the product of Run E in the patent specification could have had a diffraction pattern other than gamma (e.g., alpha). *See* Opposition, at page 16, first and second paragraphs. But that position is without rational basis.

The description requirement of Section 112 is the same no matter in what context it arises (interference, claim to priority of a U.S. patent, claim to priority of a foreign patent, etc.); it is precisely for the reason that it arises in so many contexts that it is so important.[6] Whether or not the inventor in *Langer* actually appreciated his invention at the time the application was filed was *not* even considered by the CCPA in determining whether the description requirement was met.[7] Finally, the ground for

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[6] Indeed, in its decision below, the Federal Circuit said that the standard followed in *Langer* "is consistent with that of the other cases on the issue of compliance with section 112, first paragraph." *See* Petition, Appendix B at B11, lines 4-14. Moreover, Kennecott's reference to "constructive reduction to practice" is disingenuous. Constructive reduction to practice of a particular invention occurs when an application is filed describing the invention *in accordance with the written description requirement (and other requirements) of Section 112.* Donald S. Chisum, *Patents*, Vol. 3, §10.05 at p. 10-74 (1987); *Hazeltine Corp. v. United States*, 820 F.2d 1190, 1196 (Fed. Cir. 1987) ("filing of a patent application is a constructive reduction to practice"). In *Langer*, there was no constructive reduction to practice because the specification did not describe the claimed invention *in accordance with the written description requirement of Section 112.* 465 F.2d at 917-19.

[7] To the contrary, it was considered by the CCPA in connection with its determination of whether prior to the filing of the patent application the product had been "actually reduced to practice." 465 F.2d at 919-20. Actual reduction to practice of an invention requires not only that a physical embodiment of the invention be constructed (*UMC Electronics Co. v. United States*, 816, F.2d 647, 652 (Fed. Cir. 1987), *cert. denied*, ___ U.S. ___, 108 S.Ct. 748, 98 L.Ed.2d 761 (1988)), but also that the inventor must appreciate the existence of the invention (*Heard v. Burton*, 333 F.2d 239, 243 (CCPA 1964)). That

the CCPA holding that the patent specification failed to meet the description requirement was *not* that Run E could in fact give a diffraction pattern other than gamma, since extrinsic evidence established that the form *was* in fact gamma. *Id.*, 465 F.2d at 920. Rather, the specification was defective because "*the '488 specification disclosure* does not necessarily lead to the conclusion that the Run E product was the gamma form." *Id.*, 465 F.2d at 918-19 (emphasis added). The same is true here. The'954 patent application does not mention, refer to, define, or describe the term "equiaxed microstructure." From a reading of the specification, it is impossible to discern whether the product has an equiaxed microstructure or some other microstructure. Therefore, the specification does not necessarily lead to the conclusion that the ceramic body will have an equiaxed microstructure.

F. The Federal Circuit's Decision Below Was Anything But "Fair"; It Was In Error And Should Be Reversed

Kennecott argues that the Federal Circuit's decision below was "fair." *See* Opposition, at page 17, §D. Nothing could be farther from the truth. It was Kennecott, not Kyocera, whose actions have resulted in the '299 patent being invalid under Section 102(b).[8] It would be fundamentally *unfair* to hold Kyocera subject to liability for alleged infringement of a patent which is

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completely separate issue, pertinent to the interference proceeding in *Heard* but not relevant here, was addressed by the CCPA *after* the CCPA had completed its analysis finding Section 112's description requirement not met. 465 F.2d at 917-19.

[8] Kennecott filed the '954 patent application on June 5, 1975, but deliberately delayed almost three years (until May 1, 1978) and more than one year after selling equiaxed products, to file another application (the '299 patent application) which mentioned for the very first time an equiaxed microstructure.

plainly invalid under Section 102(b), by torturing the language of Section 112 to sanction resort to the making and microscopic study of products to fulfill the statute's requirement that the patent "specification shall contain a written description of the invention."

G. Summary Of Reasons For Granting The Writ

In sum, Kennecott's Opposition presents nothing which detracts from the reasons stated in the Petition for issuing a Writ of Certiorari to review the judgment of the Federal Circuit. Section 112's description and other disclosure requirements, represent Congress' judgment as to the best means for ensuring the progress of science and the useful arts through the patent laws as expressed in the Constitution. The decision of the Federal Circuit, liberally construing the statute as allowing resort to matters outside the patent specification to identify and describe the invention, is contrary to the plain meaning of the statute which unequivocally states that "[t]he specification shall contain a written description of the invention." The decision is also inconsistent with the spirit of this Court's decisions applying Section 112's predecessor statute as well as with precedent of the Federal Circuit. Review by this Court is thus critical to provide necessary guidance as compliance with Section 112's description requirement is an issue which arises in a great number of contexts. Finally, review and reversal by this Court will terminate litigation over the '299 patent in the action below and in potential disputes with other parties.

CONCLUSION

For the reasons stated in the Petition and this Reply Brief, this Court should grant the Petition for Certiorari to review the judgment of the Federal Circuit.

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